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IN THE

Supreme Court of the United States

October Term, 1954.

No. 315

GENE AUTRY,

Appellant and Petitioner,

vs.

REPUBLIC PRODUCTIONS, INC., a corporation, HOLLYWOOD TELEVISION SERVICE, INC., a corporation, and REPUBLIC PICTURES CORPORATION, a corporation,

Appellees and Respondents.

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

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Appellees and Respondents.

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

May It Please The Court:

Appellant and petitioner, Gene Autry, respectfully petitions this Honorable Court for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit to review the decision of that Court in the above-entitled cause.

The Opinions Below.

The above entitled cause was tried in the United States District Court for the Southern District of California, Central Division, before the Honorable Ben Harrison, United States District Judge. Judge Harrison's Opinion is reported at 104 F. Supp. 918; said Opinion is set forth on pages 6 to 20 of the Appendix hereto. [Also see R. 223-239.]

The Judgment of the District Court has not been reported but is set forth on pages 39 to 42 of the Appendix hereto. [Also see R. 279-282.]

Since we deem the District Court's Findings of Fact and Conclusions of Law material to the consideration of this Petition, said Findings and Conclusions are set forth on pages 21 to 38 of the Appendix hereto. [Also see R. 259-279.]

The District Court Judgment for appellees was modified, and affirmed as modified, by the United States Court of Appeals for the Ninth Circuit. The Opinion of the Court of Appeals is reported at 213 F. 2d 667 and appears on pages 1 to 5 of the Appendix hereto. [Also see R. 721-724.]

Since the Court of Appeals has treated *Republic Pictures Corporation, et al., Appellants v. Roy Rogers, Appellee,* No. 13,314 as a companion case to this cause and the Opinion in this cause makes reference to the Opinion of the Court of Appeals in the *Rogers* case, we deem it necessary to set forth the Opinion in the *Rogers* case at pages 43 to 50 of the Appendix hereto; said Opinion in the *Rogers* case is reported at 213 F. 2d 662.

Jurisdiction.

Gene Autry, plaintiff and appellant below, and petitioner herein (for convenience, hereinafter referred to as "Autry") is a citizen of the State of California. The defendants and appellees below, and respondents herein, are Republic Pictures Corporation, a New York corporation, and its two wholly owned subsidiaries, Republic Productions, Inc., a New York corporation, and Hollywood Television Service, Inc., a Delaware corporation. For convenience the name "Republic" will be used to refer to all the respondents, since their rights and liabilities are identical. [Finding No. V, R. 261; App. p. 22.]

This cause involves 57 motion pictures produced and owned by Republic, in which motion pictures Autry portrays the leading role as an existing person, himself, and not a fictional character.

Autry filed his Complaint in the United States District Court, seeking declaratory relief and an injunction restraining Republic from using Autry's name, voice and likeness, and the motion pictures containing Autry's name, voice and likeness, for commercial advertising purposes. [R. 3-36, 221-222.]

The first cause of action of Autry's Complaint sought an injunction based on the employment agreements between Autry and Republic pursuant to which the motion pictures were produced. The second cause of action sought declaratory relief of an actual controversy between Autry and Republic with respect to said employment agreements.[1]

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[1]The basic error of the Court of Appeals appears in the first sentence of that Court's Opinion in which the Court states that Autry brought this action for an injunction. [App. p. 1; R. 721.] The entire Opinion, as well as the first sentence thereof, ignores Autry's cause of action for declaratory relief.

The first and second cause of action alleged diversity of citizenship and invoked the jurisdiction of the District Court under Section 1332(1) of Title 28, U. S. Code; the District Court found that it had jurisdiction pursuant to said section of the Judicial Code. [App. p. 22; R. 260.]

In the third cause of action, Autry sought the same injunctive relief but based his claim on the Lanham Act, Sections 1121, 1126(b), (h) and (i) of Title 15, U. S. Code. Jurisdiction of the District Court was invoked pursuant to Section 1331 of Title 28, U. S. Code; plaintiff deliberately omitted alleging the requisites for diversity of citizenship jurisdiction.

The District Court found that as to this cause of action for unfair competition, jurisdiction was invoked under Section 1331 of Title 28, U. S. Code [App. p. 22; R. 260-261], but refused to make any finding as to its jurisdiction over said third cause of action. [See R. 241.]

On August 18, 1952, the District Court entered judgment for Republic. [App. pp. 39 to 42; R. 279-282.]

Autry filed his Notice of Appeal to the United States Court of Appeals for the Ninth Circuit on August 26, 1952. [R. 283.]

The Court of Appeals had jurisdiction pursuant to Section 1291 of Title 28, U. S. Code.

On June 4, 1954, the Court of Appeals filed and entered its judgment affirming the judgment of the District Court, as modified. [R. 725.]

On July 3, 1954, Autry filed his petition for a rehearing by the Court of Appeals.

On July 16, 1954, the Court of Appeals made and filed its order denying said petition for rehearing. [R. 726.]

Jurisdiction to review said judgment of the Court of Appeals by writ of certiorari is conferred on this Court by Section 1254(1) of Title 28, U. S. Code.

Questions Presented.

I.

Under the written employment agreements between Autry and Republic, does Republic have the right to cut the motion pictures (in which motion pictures Autry portrayed himself in the leading role and in which his name, voice and likeness appear) to 53 minutes and exhibit them over television in connection with commercial advertising?

II.

The District Court judgment, declaring the respective rights and obligations of Autry and Republic under the employment agreements, held that Republic had the right to use the motion pictures and Autry's name, voice and likeness in said motion pictures for any purpose whatsoever, without restrictions or limitations, and Republic had the right to cut, edit and revise the motion pictures in any manner, to any length for any purpose.

On appeal to the Court of Appeals, Autry contended that the District Court erred in not holding that Republic's right to cut and revise the motion pictures was limited and in failing to impose limitations upon Republic's right to use and license others to use Autry's name and likeness in connection with commercial announcements. The Court of Appeals recognized that Autry's contentions were well taken, but instead of remanding the cause to determine what limitations are to be imposed on Republic, the Court of Appeals erroneously held that said issues were not

presented herein. This holding completely ignores Autry's cause of action for declaratory relief.

Accordingly, the propriety of denying a litigant the remedy of declaratory relief is put in issue. The importance of the issue in this cause is heightened by reason of the fact that the failure to afford plaintiff declaratory relief will result in a multiplicity of actions not only with respect to the motion pictures involved herein, but with respect to the rights and obligations of many producers of motion pictures.

III.

The District Court refused to find that it had jurisdiction over the third cause of action of Autry's Complaint wherein he alleged unfair competition pursuant to rights and remedies granted by the Lanham Act, particularly, Sections 1121, 1126(b), (h) and (i) of Title 15, U. S. Code. The Court of Appeals did not rule on the District Court's failure to assume jurisdiction.

The propriety of the District Court's action in refusing to assume jurisdiction is at issue herein.

IV.

The third cause of action presents a very important question arising under the Lanham Act, not heretofore decided by this Court, to wit, whether citizens of the United States have the same rights and remedies against other citizens of the United States granted nationals of foreign countries by Section 44(b) of the Lanham Act. [15 U. S. C., Sec. 1126(b).]

Statutes and Treaties Involved.

Judicial Code.

28 U. S. C., SECTION 1331:

The district courts shall have original jurisdiction of all civil actions wherein the matter in controversy exceeds the sum or value of $3,000, exclusive of interest and costs, and arises under the Constitution, laws or treaties of the United States.

28 U. S. C., SECTION 2201:

In a case of actual controversy within its jurisdiction, except with respect to Federal taxes, any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought. Any such declaration shall have the force and effect of a final judgment or decree and shall be reviewable as such.

Lanham Act.

15 U. S. C., SECTION 1121:

The district and territorial courts of the United States shall have original jurisdiction, the circuit courts of appeal of the United States and the United States Court of Appeals for the District of Columbia shall have appellate jurisdiction, of all actions arising under this chapter, without regard to the amount in controversy or to diversity or lack of diversity of the citizenship of the parties.

15 U. S. C., SECTION 1126(b):

Persons who are nationals of, domiciled in, or have a bona fide and effective business or commercial establish-

ment in any foreign country, which is a party to (1) the International Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883; or (2) the General Inter-American Convention for Trade Mark and Commercial Protection signed at Washington on February 20, 1929; or (3) any other convention or treaty relating to trade-marks, trade or commercial names, or the repression of unfair competition to which the United States is a party, shall be entitled to the benefits and subject to the provisions of this chapter to the extent and under the conditions essential to give effect to any such conventions and treaties so long as the United States shall continue to be a party thereto, except as provided in the following subsections of this section.

15 U. S. C., SECTION 1126(h):

Any person designated in subsection (b) of this section as entitled to the benefits and subject to the provisions of this chapter shall be entitled to effective protection against unfair competition, and the remedies provided in this chapter for infringement of marks shall be available so far as they may be appropriate in repressing acts of unfair competition.

15 U. S. C., SECTION 1126(i):

Citizens or residents of the United States shall have the same benefits as are granted by this section to persons described in subsection (b) of this section.

Treaties.

THE INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY (signed at Paris on March 20, 1883, amended at London on June 2, 1934), ARTICLE 10 *bis* [53 Stat. 1748, 1768 at p. 1780], provides in part:

(1) The countries of the Union are bound to assure to nationals of countries of the Union an effective protection against unfair competition. (2) Any act of competition contrary to honest practice in industrial or commercial matters constitutes an act of unfair competition.

(3) The following particularly are to be forbidden:

1. All acts whatsoever of the nature to create confusion in any way whatsoever with the establishment, the goods, or the services of the competitor;

2. False allegations in the conduct of trade of a nature to discredit the establishment, the goods or services of a competitor.

THE GENERAL INTER-AMERICAN CONVENTION (signed at Washington on February 20, 1929) ARTICLE 20 [46 Stat. 2907 at pp. 2930 and 2932], provides:

Every act or deed contrary to commercial good faith or to the normal or honorable development of industrial or business activities shall be considered as unfair competition and, therefore, unjust and prohibited.

Statement of the Case.

Autry has a valuable business using his name and likeness in commercial advertising, both in licensing the use of his name and likeness in connection with the advertisement of products, commodities and services and the endorsement of products, commodities and services. This business was begun by Autry prior to his first employment by Republic's predecessor, Mascot Pictures Corporation, and was built up during his employment with Republic, with the full knowledge and consent of Republic.

Autry rendered his services for Republic as an actor in 57 feature length motion pictures, which services were rendered pursuant to 5 written employment agreements entered into in 1934, 1936, 1938, 1942 and 1946.[2]

Autry performed the leading role in each of said motion pictures and said motion pictures were generally referred to as the "Autry pictures." It is important to the consideration of this petition to note that Autry portrayed himself in said motion pictures, and not a fictional character.

At all times Autry retained exclusive control over his commercial advertising business. At no time during Autry's employment by Republic did Republic use Autry's name or likeness, whether in said Autry motion pictures, or otherwise, in commercial advertising. [R. 486-487.]

Republic's ownership of the said motion pictures is not disputed; nor does Autry dispute Republic's right to exhibit, and to license others to exhibit said motion pictures on television. However, it is Autry's position that the

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[2]Said written employment agreements, and the amendments thereto, were appended to Republic's Answer as Exhibits A to I thereof. [R. 46-211.]

contracts do not give Republic the right to use, or license others to use Autry's name, voice or likeness in commercial advertising, whether said name, voice or likeness appear in said motion pictures or elsewhere.

Republic proposes to cut said motion pictures to 53½ minutes and license them for exhibition on 1 hour commercially sponsored television programs. Republic has offered to license the commercially sponsored television exhibition of these "Gene Autry Productions starring Gene Autry" in groups of 13, 26 or 52. [R. 211-212.]

Pursuant to the first cause of action of his Complaint, Autry sought to enjoin this proposed licensing on the ground that the employment contracts between Republic and Autry do not authorize Republic to use, or license others to use Autry's name, voice and likeness, whether in said motion pictures or otherwise, in connection with commercial advertising. No question was raised as to Republic's right to televise the motion pictures.[3]

At the trial of this cause, Autry's witnesses testified, without contradiction, that the use of the Autry motion pictures on a sponsored television program would be a commercial advertising use. These witnesses pointed out that the motion pictures would be televised to assemble an audience attracted by Autry; that audience would be used as recipients of the advertising message telecasted before, during and after the exhibition of the motion pictures; the strength of the association between Autry and the advertised product would be increased by the regular and repetitious exhibition of the Autry

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[3]There is no question but that Republic has the right to use Autry's name, voice and likeness in connection with the advertising and exploitation of said motion pictures.

motion pictures in groups of 13, 26 or 52 and the concurrent repetitious use of Autry's name and likeness in the announcements of the exhibition of the motion pictures during the "commercials" as well as in the motion pictures. The peculiar fact that Autry portrayed himself as a real person in the motion picture enhanced the advertising value of these motion pictures.

The District Court held that Republic, as the owner of the motion pictures, had the right to license the television exhibition of the pictures on commercially sponsored programs and denied the injunction.[4]

In Autry's second cause of action he sought declaratory relief with respect to an actual controversy between Autry and Republic, which controversy required the determination of the question as to whether the employment agreements permit Republic:

> ". . . to cut, edit and otherwise revise the motion pictures and to license others (to do likewise) . . . in any manner, to any length and for any purpose . . ."[5]

Republic's Answer admitted that such controversy existed between the parties and alleged that they claimed (and Autry controverted) the right to use the motion

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[4]As heretofore noted, with respect to the first cause of action, jurisdiction was conferred on the District Court pursuant to Section 1332(1) of Title 28, U. S. Code, by reason of the diversity of citizenship of the parties.

[5]See: Autry's Complaint [R. 14-22], and in particular paragraphs IX, A, (2) and IX, B, (5) of the second cause of action [R. 42-45], in particular paragraph IV, (1), (2) and (3) [R. 43-44]; Findings Nos. XIV, XVIII, XIX, XXI and Conclusions Nos. III, IV, V and VII [R. 265-270, 277-279; App. pp. 26-30, 36-38].

pictures "for any purpose and in any manner whatsoever." [R. 44.][6]

The District Court declared that Republic had the right to use the Autry motion pictures "without restriction or limitation" and could "cut, edit and otherwise revise and to license others to cut, edit and otherwise revise said motion pictures at any time . . . in any manner, to any length and for any purpose . . ."[7]

The Court of Appeals held:

> "Appellant has put in issue the breadth and sweep of this judgment. We agree with appellant that this broad language nullifies all of the clauses in the employment contracts which were introduced therein for the protection of appellant with reference to the type and quality of photoplays in which he rendered his services. The issue tendered to the trial court was whether appellees could make use of the motion pictures in the manner proposed; the issue was not one of ascertaining what other uses could be made of them, or how far appellees might go. Because this part of the judgment goes beyond the issues presented to the trial court, we hereby disapprove of it. We simply hold that appellees should not be enjoined from cutting the appellant's performances to approximately 53 minutes, and showing them in connection with commercial advertising over television, pursuant to a License Agreement such as that above quoted." [R. 723-724; App. p. 4.]

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[6]As heretofore noted, with respect to the second cause of action, jurisdiction was conferred on the District Court pursuant to Section 1332(1) of Title 28, U. S. Code, by reason of the diversity of citizenship of the parties.

[7]See Finding No. XIV [R. 265-267; App. pp. 26-27] and the Judgment [R. 280-281; App. pp. 39-40].

The Court of Appeals also recognized that the television "exhibition could be so 'doctored' as to make it appear that the artist (Autry) actually endorses the products of the programs' sponsors." [R. 722-723; App. p. 3.]

By limiting its consideration to the issue of whether the injunction should issue, the Court of Appeals has denied Autry the declaratory relief he is entitled to have pursuant to Section 2201 of Title 28, U. S. Code.

As heretofore noted, Autry's third cause of action sought relief on the grounds of unfair competition, basing his claim on Sections 1121, 1126(b), (h) and (i) of Title 15, U. S. Code (Lanham Act) and invoking jurisdiction of the District Court under Section 1331 of Title 28, U. S. Code.

The District Court refused to find that it had jurisdiction over the third cause of action. Accordingly, it failed to consider the very important question as to whether Autry was entitled to the same protections of the International Convention for the Protection of Industrial Property and the General Inter-American Convention for Trade Mark and Commercial Protection against acts of other United States citizens as is afforded to nationals of foreign countries by Section 1126(b) of Title 15, U. S. Code.

ARGUMENT.

I.

Reasons Relied on for Allowance of Writ.

1. It is clear that in writing its Opinion, the Court of Appeals overlooked Autry's second cause of action for declaratory relief, thereby rendering the determination of this cause incomplete. We submit that in doing so the Court of Appeals has so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

2. As to Autry's third cause of action, the District Court simply found that Autry invoked jurisdiction under Section 1331 of Title 28, U. S. Code, but refused to find that it had or did not have jurisdiction. The Court of Appeals was asked to rule upon this matter but has not done so. We submit that in failing to correct the District Court's refusal to make a finding as to its jurisdiction, the Court of Appeals has so far sanctioned a departure from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

3. Similarly, both the District Court and Court of Appeals have failed to consider the questions presented by the third cause of action as to the extent of the protection afforded citizens and residents of the United States under Section 1126(b), (h) and (i) of Title 15, U. S. Code; which questions have not heretofore been ruled upon by this Court and, we submit, should be settled by this Court.

4. We have been informed by counsel for Roy Rogers that concurrently with the filing of this petition, Roy Rogers will also file his petition for writ of certiorari to review the decision of the Court of Appeals in *Republic Pictures Corporation, et al., Appellants vs. Roy Rogers, Appellee,* No. 13,314. The precise question presented by the first cause of action in this cause is also presented in the *Rogers* case, to wit, the right of Republic, as owner of the motion pictures, to use the motion pictures containing the name, voice and likeness of the artist appearing in said motion pictures, for commercial advertising purposes, including, but not limited to, the television exhibition of the motion pictures on commercially sponsored programs. The settlement of this question is of great importance to the motion picture industry, the television industry and the commercial advertising business; accordingly, we submit that this Court should fully and completely settle this question.

II.

The Pleadings Below Presented Issues Which the Court of Appeals Held Was Not Before the Trial Court.

Republic, as well as Autry, invoked the jurisdiction of the District Court for a judgment declaring the respective rights and obligations of the parties under the employment agreements pursuant to which the Autry motion pictures were produced.

Republic sought a judgment declaring that they had the right to use the motion pictures without any limita-

tions or restrictions whatsoever, that they could use the motion pictures in any manner and for any purposes whatsoever and that they had the right to cut, edit and otherwise revise the motion pictures in any manner, to any length and for any purpose whatsoever.

The District Court rendered a declaratory judgment.[8] The Court of Appeals indicated that the judgment was incorrect, but instructed the District Court to delete the declaratory portion of its judgment instead of having the judgment corrected to be consistent with the Opinion of the appellate court or remanding the cause for further proceedings consistent with the Opinion.

One of the purposes of the declaratory relief action was to obtain a ruling as to the limitations and restrictions, if any, on Republic's right to cut, revise and edit the motion pictures and the manner of using these motion pictures.

The Court of Appeals, in holding that the issues as to how far Republic could go were not before it, has denied Autry a full and complete consideration of his appeal.

As a result of the decision of the Court of Appeals, the judgment in this cause is incomplete and fails to declare the respective rights and obligations of the parties with respect to the actual controversy which Autry and Republic presented for adjudication.

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[8]The judgment expressly recited that the Court was declaring the rights of the parties with respect to the controversy alleged in the Complaint [R. 280; App. p. 39]; see also Conclusion of Law No. VII. [R. 278; App. p. 38.]

III.

The Incomplete Judgment Will Result in a Multiplicity of Actions.

As a result of the incomplete judgment, Autry and Republic are uncertain as to their respective rights which they asked the District Court to adjudicate.

The declaratory relief action was instituted in order that Autry might determine in advance just how far Republic could go in using the motion pictures. The Court of Appeals said that Republic's rights are not unlimited and unrestricted. In the absence of a ruling delineating the rights of the parties, Republic and its licensees will act at their peril. More important, Autry will have to police the actions of Republic and its many licensees throughout the country (and perhaps in foreign countries) and institute appropriate actions to enforce what Autry may believe to be his rights. Such actions against Republic's licensees will have to be brought in whatever forum jurisdiction over the licensees can be obtained.

This will result in a multiplicity of actions in different forums. The remedy of declaratory relief was created to prevent this type of situation.

Having noted that Republic's rights are not unlimited and unrestricted, the Court of Appeals should have given full and complete consideration to the questions presented or remanded the cause to the District Court for a redetermination of the questions, consistent with the appellate court Opinion, as to just how far Republic and its licensees can go in editing, cutting and revising the motion pictures, and to determine for what purposes and in what manner the motion pictures can be used.

IV.

The Question as to Whether or Not the District Court Has Jurisdiction Over the Third Cause of Action Should Be Resolved.

We submit that when jurisdiction of the District Court is invoked, the Court must, at the outset, determine whether or not it has jurisdiction.

In the within cause, the District Court simply found that jurisdiction over the third cause of action was invoked under Section 1331 of Title 28, U. S. Code, but refused to find whether or not the Court had jurisdiction. (See Autry's Objections to Finding No. IV [R. 241]; and Finding No. IV [R. 260-261; App. p. 22].)

V.

The Court Should Settle the Question as to Whether the Lanham Act Affords Citizens and Residents of the United States the Protections of the Treaties Therein Mentioned and Incorporates Said Treaties as Part of a National Law of Unfair Competition and Trade-mark.

Section 44(b) of the Lanham Trade-Mark Act provides:

> "Persons who are nationals of, domiciled in, or have a *bona fide* and effective business or commercial establishment in any foreign country, which is a party to (1) the International Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883; or (2) the General Inter-American Convention for Trade Mark and Commercial Protection, signed at Washington on February 20, 1929; or (3) any other convention or treaty relating to trademarks, trade or commercial names, or the repression

> of unfair competition to which the United States is a party, shall be entitled to the benefits and subject to the provisions of this chapter to the extent and under the conditions essential to give effect to any such conventions and treaties so long as the United States shall continue to be a party thereto, except as provided in the following subsections of this section." [15 U. S. C., Sec. 1126(b).]

Apparently, this section was little more than declaratory of the constitutional provision relating to treaty power. (See *Bacardi Corporation v. Domenech* (1940), 311 U. S. 150, 161, 61 S. Ct. 219, 225.)

However, Section 44(i) of the Lanham Trade-Mark Act was new and revolutionary. It provides:

> "Citizens or residents of the United States shall have the same benefits as are granted by this section to persons described in subsection (b) of this section." [15 U. S. C., Sec. 1126(i).]

It is our contention that this section incorporated into the American law applicable to persons domiciled in the United States, all of the benefits that are extended to foreigners under the Trade-Mark Conventions. As a result, the various trade-mark treaties become statutes of the United States governing the rights of citizens *inter sese.*

The District Court and Court of Appeals failed to consider this contention. We submt that the question is of sufficient importance to warrant this Court's consideration of the problem.

If our contention is well taken, then the cause should be remanded to determine the scope of protection afforded

Autry under the two treaties mentioned in Section 44(b) of the Lanham Act [15 U. S. C., Sec. 1126(b)]; the relevant portions of said treaties are set forth on page 9, *supra*.

VI.

Republic's Ownership of the Motion Pictures Does Not Give It the Right to Use Autry's Name, Voice and Likeness, Whether in the Pictures or Outside the Pictures for Commercial Advertising Purposes.

The courts below have proceeded on the theory that since Republic owns the motion pictures and Autry agreed that Republic owns all rights in the motion pictures, Republic can use its property in a manner which infringes upon Autry's exclusive right to use his name, voice and likeness for commercial advertising purposes.

The requirements of brevity and conciseness prevent the presentation of an analysis of the employment agreements to support our position with respect to this question.

However, we submit the writ should be granted to review this important question as to whether incidents of ownership of property include the right to use the property in such a manner as to infringe upon the personal rights of another person.

The importance of settling this question with respect to motion pictures is emphasized by reason of the fact that it is vitally important to the entire entertainment and advertising industries to have a final, conclusive and complete ruling upon the question by the Supreme Court of the United States.

Conclusion.

We submit that the questions presented herein are important and should be determined by the Court for the reasons above stated. Moreover, the departures from the accepted and usual course of judicial proceedings hereinabove noted are such as to call for an exercise of this Court's power of supervision.

Dated: August 27, 1954.

MARTIN GANG and
MILTON A. RUDIN,
By MILTON A. RUDIN,
Counsel for Petitioner, Gene Autry.

NORMAN R. TYRE,
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APPENDIX.

United States Court of Appeals For the Ninth Circuit.

GENE AUTRY, *Appellant,* vs. REPUBLIC PRODUCTIONS, INC., *et al., Appellees.* No. 13,522, Jun. 4, 1954.

Appeal from the United States District Court for the Southern District of California, Central Division.

Before: HEALY, BONE and POPE, Circuit Judges.

BONE, Circuit Judge.

Appellant brought this action for an injunction, to restrain appellees from exhibiting motion pictures in connection with commercially sponsored or sustaining television broadcasts, where those motion pictures contain appearances of appellant. In its opinion below (104 F. Supp. 918) the District Court gave judgment to appellees, holding that the contracts between appellees and appellant placed no restrictions upon appellee's use or exhibition of the motion pictures. There were five contracts executed over a period of a dozen years, but the contracts are sufficiently similar that they need not be discussed individually. The trial judge used paragraph 9 of the 1938 contract as an example. That was fair to both parties, and we shall do likewise:

> "9. The producer shall have the right to photograph and/or otherwise reproduce any and all of the acts, poses, plays and appearances of the artist * * * during each employment period, and to record for motion picture purposes the voice of the artist * * * and to reproduce and/or transmit the same in connection with such acts, poses, plays and appearances as the producer may desire, and the producer shall own solely and exclusively all rights of every kind

(Autry Opinion, cont.)

> and character whatsoever in and to the same perpetually, including the right to use and exploit all or any part of the same in such manner as the producer may desire, and including, as well, the perpetual right to use the name and likeness of the artist and recordations and reproductions of his voice in connection with the advertising and exploitation thereof. The artist does hereby also grant to the producer the right to make use of and to allow others to make use of his name (in addition to and other than in connection with the acts, poses, plays and appearances of artist hereunder) for the purpose of advertising, exploiting and/or publicizing photoplays in which the artist appears, as well as the right to make use of and distribute his physical likeness and his voice for the like purpose * * *."

This contract, like the contracts in Republic Pictures Corporation, *et al.* v. Roy Rogers, No. 13,314, June ....., 1954, (9 Cir., ... F. 2d .....) contains the descriptive words (1) "acts, poses, plays and appearances" and (2) "name, voice, and likeness." As set forth in our opinion in the Rogers case, we interpret these two sets of words as applying to two different and distinct subject matters. The former refers to the artist's activities or appearances in a motion picture as such; the latter set of words refers to a reproduction of the name, voice or likeness of the artist apart from his activities or appearances in the former, and lacking the motion and dynamic and dramatic qualities contained in motion pictures. There are limitations placed upon appellees' use of the latter, but appellant granted for valuable consideration all rights, unrestricted, to appellees in their ownership of the former.

(Autry Opinion, cont.)

Although appellees unquestionably have the right to cut and edit the motion pictures, and to license others to do the same, we can conceive that some such cutting and editing could result in emasculating the motion pictures so that they would no longer contain substantially the same motion and dynamic and dramatic qualities which it was the purpose of the artist's employment to produce. And although appellees unquestionably have the right to exhibit the motion pictures in connection with or for the purpose of advertising commercial products of all sorts, we can conceive that some such exhibitions could be so "doctored" as to make it appear that the artist actually endorses the products of the programs' sponsors.

The record in this case shows that the appellees proposed to license motion pictures featuring appellant, which said pictures would be edited to 53 or 53½ minutes each, in length, thus permitting approximately 7 minutes of advertising in an hour television program. It was this proposed use that was alleged in appellant's complaint and as to which an injunction was asked. The parties stipulated that the License Agreement through which the pictures were proposed to be exhibited, expressly prohibited "* * * any advertising * * * [or] any statements which * * * may be understood to be an endorsement of any sponsor * * * [etc.] by * * * any actor or actress appearing therein * * * or * * * that any such person is connected or associated with * * * Station or any Sponsor. * * * All advertising issued * * * relating to any picture shall give cast and due credit in the same manner * * * as such credits appear in the main title of the respective picture."

(Autry Opinion, cont.)

The issue here, is whether appellees should be enjoined from cutting the appellant's performances to approximately 53 minutes, and showing them in connection with commercial advertising over television, pursuant to a License Agreement such as that above quoted. The judgment from which the appeal is taken goes farther than the printed opinion, in that it expressly permits appellees:

> "* * * to cut, edit and otherwise revise and to license others [to do likewise] * * * in any manner, to any length and for any purpose * * *."

Appellant has put in issue the breadth and sweep of this judgment. We agree with appellant that this broad language nullifies all of the clauses in the employment contracts which were introduced therein for the protection of appellant with reference to the type and quality of photoplays in which he rendered his services. The issue tendered to the trial court was whether appellees could make use of the motion pictures in the manner proposed; the issue was not one of ascertaining what other uses could be made of them, or how far appellees might go. Because this part of the judgment goes beyond the issues presented to the trial court, we hereby disapprove of it. We simply hold that appellees should not be enjoined from cutting the appellant's performances to approxmately 53 minutes, and showing them in connection with commercial advertising over television, pursuant to a License Agreement such as that above quoted.

Appellant has raised the issue of unfair competition and the possible application of the Lanham Act (Title 15, U. S. C. A. §§1125 and 1126.) Even aside from the

consent which we find was given by appellant to appellees in the contracts, appellant argues that appellees might so alter or emasculate the motion pictures as to render them substantially different from the product which the artist produced. Further, that the exhibition of old pictures which depict appellant in clothes which are no longer in style, and in autos which are no longer modern, could be quite harmful to his modern reputation. As to the latter point, the consent which we have found in the contracts extends to this risk. As to the question of appellees' emasculating the pictures, we have attempted to leave that question open, to be properly presented when and if the occasion arises; we have disapproved that part of the lower court judgment which could be considered authority for such possible abuse, although our disapproval should not be taken as passing on the merits of what was there said. Appellant is not in a position to further urge unfair competition, since it is our interpretation of the contracts that appellant consented to such exhibition of the pictures as is proposed here.

As herein modified, the judgment of the trial court is affirmed.

(Endorsed:) Opinion. Filed Jun. 4, 1954.

Paul P. O'Brien, Clerk.

In the United States District Court, Southern District of California, Central Division.

GENE AUTRY, *Plaintiff, vs.* REPUBLIC PRODUCTIONS, INC., a corporation, HOLLYWOOD TELEVISION SERVICE, INC., a corporation, etc., *Defendants.* No. 13596-BH.

OPINION.

Appearances: Gang, Kopp & Tyre, 6400 Sunset Blvd., Hollywood 8, Calif., Attorneys for Plaintiff; Loeb & Loeb, 523 West 6th Street, Los Angeles 14, California, Attorneys for Defendants.

Plaintiff, a well-known star of radio, movies and television, seeks to restrain the defendants, Republic Productions, Inc. (hereinafter referred to as Republic), and Hollywood Television Service, Inc., from licensing for exhibition on home television receivers fifty-six films owned by Republic and in which plaintiff appeared in starring roles.

Plaintiff has and claims no property interest in the films themselves but does contend the showing of these films on home television, either on a "sustaining" or "sponsored basis," would constitute "commercial advertising"; that such "commercial advertising" is in violation of the contracts of employment between Republic and himself. Plaintiff further contends that this is unfair competition with the "commercial advertising" business which the plaintiff has established during the years of his fame and public acceptance.

Defendants' reply to these contentions is that pursuant to the contracts between the parties, and by virtue of defendants' copyrighted control of said films, defendants' right to license the exhibition of the pictures are unre-

stricted. [Lillie v. Warner Bros. Pictures, 139 Cal. App. 724; 34 Pac. 2d 835.]

This case presents one of the many questions constantly arising as a result of the impact of television upon the entertainment world.

Plaintiff first entered the entertainment field in 1928 or 1929. Between that time and his first film contract, he performed on various radio programs, made personal appearances and records, and granted the first of many commercial endorsements.

By 1933, plaintiff testified, his yearly income was about $15,000.00.

On or about September 4, 1934, plaintiff entered into a contract of employment with Mascot Pictures Corporation. This contract was assigned by Mascot to Republic June 11, 1935, and under the provisions of the 1934 contract and its assignment, plaintiff was featured in eight pictures.

Further employment contracts were entered into between plaintiff and Republic in the years 1936, 1938, 1942, and 1946. No pictures were made under the 1942 contract but its terms were apparently incorporated in the 1946 contract. The 1934 contract was a "term" contract. The other contracts are what is known as "multiple picture contracts." The photoplays involved herein were produced under said contracts and shall hereafter be referred to as the contracts of 1934, 1936, 1938 and 1946 respectively.

The parties have stipulated that "plaintiff has achieved a world-wide reputation as 'America's Favorite Cowboy' and as a western star of great fame and prominence. The joint efforts and expenditures of defendants and plaintiff

(Autry District Court Opinion, cont.)

in publicizing and exploiting the name and reputation of the plaintiff, the photoplays produced by defendants in which plaintiff appeared, the world-wide release and distribution of the aforementioned photoplays by defendants, plaintiff's personality and ability, and his appearances in rodeos and other type of entertainment on radio and television, have all substantially contributed thereto, but it is not possible to estimate the amount or relative proportion and contribution of each."

When plaintiff entered into the first contract he did not have the benefit of counsel but thereafter was represented by able counsel and an alert agent. As his fame increased his bargaining power increased. Plaintiff's commencement salary in 1934 was $100.00 per week. The last pictures he made for Republic in 1947, were at the rate of $15,000.00 per picture. This bargaining power was not only reflected in his increased earnings but also in the freedom of plaintiff to carry on his independent activities in which his name, pictures, photographs and other reproductions of his likeness and voice were freely bartered for use by others.

It has been further stipulated that: "Each of said photoplays were published with notice of copyright affixed and registered under the Copyright Laws of the United States in the Office of the Register of Copyrights by and in the name of Pictures (Republic) as the copyright proprietor. Plaintiff has and claims no right to use or to license the use of said photoplays, or his acts, poses, plays and appearances therein for television, or for any other purpose whatsoever, unless defendants consent thereto; except, however, that the plaintiff does not concede that defendants have the unrestricted right to use the same,

(Autry District Court Opinion, cont.)

and particularly urge that defendants do not have the right to use the same in the manner claimed by defendants and specifically set forth in plaintiff's complaint."

The main contention revolves around paragraph 9 of the first three contracts and paragraph 8 of the 1946 contract. The parties have used paragraph 9 of the 1938 contract as an example, consequently, I shall do the same. Said paragraph 9 reads as follows:

"The producer shall have the right to photograph and/or otherwise reproduce any and all of the *acts, poses, plays and appearances* of the artist of any and all kinds during each employment period, and to record for motion picture purposes the voice of the artist and all instrumental, musical and other sound effects produced by him hereunder, and to reproduce and/or transmit the same in connection with such *acts, poses, plays and appearances* as the producer may desire, and the producer shall own solely and exclusively all rights of every kind and character whatsoever in and to the same perpetually, including the right to use and exploit all or any part of the same in such manner as the producer may desire, and including, as well, the perpetual right to use the name and likeness of the artist and recordations and reproductions of his voice in connection with the advertising and exploitation thereof. The artist does hereby also grant to the producer the right to make use of and to allow others to make use of his name (in addition to and other than in connection with the *acts, poses, plays and appearances of* the artist hereunder, for the purpose of *advertising, exploiting and/or publicizing photoplays in* which the artist appears, as well as the right to make use of and distribute and to allow others to make use of and distribute his

(Autry District Court Opinion, cont.)

pictures, photographs and other reproductions of his physical likeness and of his voice for the like purpose. The producer shall also have the right to 'double' or 'dub' the *acts, plays and appearances* of the artist hereunder and, as well, his voice and/or sound effects produced by him hereunder to such extent as the producer may desire. The rights granted to the producer in this paragraph shall inure not only to the benefit of the producer, but also to the benefit of all persons who may hereafter acquire from the producer the right to distribute, transmit, exhibit, advertise and/or exploit the photoplays in which the artist appears hereunder." (Emphasis supplied.)

The difference between the parties arises over the meaning of the first two sentences of said paragraph 9. Plaintiff contends the second sentence of said paragraph 9 restricts the grant set forth in the first sentence when read in connection with the other provisions of the contract.

Since completing his contract with Republic plaintiff has established his own production company, specializing in pictures for television. Through the years he also has built up a nation-wide advertising business through which he advertises dozens of products and business institutions. The pictures produced by plaintiff are used as "attention getters," "audience builders"; association of the star with the products, endorsement of products direct or implied, as well as testimonials. Plaintiff has thus combined to his great profit his skill as an actor with the advertising business. He construes the use of advertisements in connection with his televised pictures as "commercial advertising." To me, he has so commercialized his activities that he no longer looks upon his pictures as a feature of entertainment but considers them solely from the view-

(Autry District Court Opinion, cont.)

point of the sponsor and the profits derived, ignoring the approach of his unseen audience, which seeks only entertainment and endures the advertising as the price for such entertainment.

In June, 1951, Republic through its subsidiary, Hollywood Television Service, Inc., offered to license for televising the photoplays produced under the various contracts with plaintiff. The photoplays were to be used by various sponsors under the following restrictions:

"Advertising—Station shall not make or permit to be made, in any advertising, publicity, or otherwise, any statements which, directly or indirectly, expressly or by implication (a) constitute or may be understood to be an endorsement of any sponsor, product, article, or advertising by distributor, the producer or copyright proprietor of the picture, any actor or actress appearing therein, the director, or anyone else connected or associated with the picture, or the production or distribution thereof, or (b) indicate or may be understood as indicated that any such person is connected or associated with, or is employed or engaged by Station or any sponsor. Any advertising or publicity referring to such person shall be limited to, and shall indicate that such person appears in or is rendering services in connection with the specific picture or pictures. All advertising issued, published or paid for by Stations, or any sponsor, relating to any picture shall give cast and due credit in the same manner, as to position and relative size and prominence of type, as such credits appear in the main title of the respective picture."

Thus Republic, by offering the pictures produced under the various contracts entered the plaintiff's old pictures in competition with his present productions much to the

(Autry District Court Opinion, cont.)

displeasure of the plaintiff. Plaintiff contends the televising of his old pictures is not only unfair competition but contrary to the terms of the various written contracts between the parties. With this contention I cannot agree.

Plaintiff endeavors to differentiate between the exhibiting of motion pictures in theatres to "captured" audiences and exhibiting said pictures over television to the myriad of home television sets. He does not object to the televising of the pictures but does object their being sponsored by an advertiser. He claims that sponsored television is "commercial advertising." Plaintiff in effect tells defendants they may televise the photoplays involved provided their exhibition is without sponsorship. This graciousness on behalf of the plaintiff can be readily evaluated when one realizes, as a practical matter, this would preclude Republic's use or sale of photoplays in which plaintiff appeared.

In the drafting of each contract it is clear the parties herein were aware of the possible use of pictures over television but in none of them is there any restriction placed upon such use of photoplays. At all times the televising of plaintiff's pictures must have been contemplated as indicated in paragraph 20 of the 1934 contract in which the following language is used:

"Whenever in this agreement the terms 'motion picture,' 'motion picture production,' 'serials,' 'features,' and/or 'photoplays,' or terms of similar tenor are used, such terms shall be deemed to include, but not be limited to, motion picture productions of any length whatsoever, both in the present and future development of the motion picture industry, *including talking motion pictures, television and all forms of motion pictures* and their accom-

panying devices which reproduce color, words, music, and/or sound in synchronism with, accompaniment of, or supplementary to, photograph . . ." (Emphasis supplied.)

It is clear that the expression "acts, poses, plays and appearances," appearing in the first sentence of the above quoted paragraph 9, refers to photoplays and the second sentence of said paragraph applies to something entirely different.

Saul Rittenberg, one of the attorneys for Republic, was called by plainitff and testified that he was one of the drafters of the 1938 contract and in explaining the meaning of paragraph 9, testified as follows:

". . . The first sentence is intended to cover the picture, the ownership of the picture and the recordings, and the right to use them. The next sentence deals with an entirely different subject, the subject of the right to use Autry's name, the artist's name and likeness and voice for advertising purposes. They are two entirely different things. We can show the picture under the first sentence, and under the second sentence we have certain advertising rights for the purpose of exploiting those motion pictures. You asked me whether that was a form. That is very standard in the motion picture industry contracts, to cover the two things separately."

The plaintiff gave testimony to the same effect and his counsel does not dispute such interpretation.

Mr. Rittenberg further testified in substance, that the usual language when talking about ownership of pictures produced is the phrase "acts, poses, plays and appearance"; that "name and likeness" refers to advertising rights as

(Autry District Court Opinion, cont.)

distinguished from motion pictures; that there is a well understood distinction in the industry between the use of an artist's "name and likeness" in motion pictures and their use outside the picture. At no time on behalf of the plaintiff did anyone request any limitation or restriction on the producer's right to use or distribute or transmit or exhibit the pictures which plaintiff would make.

Paragraph 4 of the 1936 contract granted plaintiff—

"* * * the express right to enter into any other engagement, and/or render services in connection with vaudeville, personal appearances, radio broadcasts, phonograph records, or other forms of entertainment, excepting motion pictures and television, outside of such Exclusive Periods, . . ."

Under the provisions of paragraph 5 of the 1938 contract, plaintiff could (except when in default), render services for others during the intervening periods—

"* * * in motion pictures, dramatic, theatrical, musical, vaudeville, radio, television, commercial advertising, making phonograph recordings, or other productions, shows, performances and/or entertainment; . . ."

He was free to make one outside photoplay during each term of the contract.

Note that the term "commercial advertising" is used for the first time in the 1938 contract, and that the grant therein was broader than that found in paragraph 4 of the 1936 contract. (The latter preventing television appearances and not mentioning "commercial advertising.") It also will be observed that the parties have differentiated between television and "commercial advertising," indicat-

(Autry District Court Opinion, cont.)

ing a recognition of a distinction in the meaning of the two words.

After dealing with each other for a period of twelve years we come to the contract of 1946, wherein photoplays are defined in paragraph 2 to include:

"* * * but is not limited to motion pictures produced, exhibited with and/or accompanied by sound and/or voice recording, reproducing and/or transmitting devices, radio devices, television devices and all other improvements and devices which are now or may hereafter be used in connection with the production, exhibition and/or transmission of any present or future kind of motion picture productions. The words 'radio devices' and 'television devices' as used in the next preceding sentence hereof, shall be deemed to refer to radio devices and television devices only in connection with motion pictures, and not to radio devices and television directly from performances by living actors on the radio or in personal appearances * * *"

In an appendix to the 1946 contract enumerated as paragraph 3 it is stated:

"You shall have no right, title or interest of any kind or character whatsoever in or to any photoplay, or any right or rights in connection with the same or in or to any proceeds which may be derived by us therefrom; it being distinctly understood and agreed that the compensation payable pursuant to the provisions of paragraph— of the agreement to which this exhibit is attached, shall be measured in the manner hereinabove provided and that such compensation shall not, in any way, constitute a lien upon any photoplay, or any part thereof, or an assignment of the proceeds thereof."

(Autry District Court Opinion, cont.)

And paragraph 4 of said annex to the 1946 contract reads as follows:

"We shall have full charge and control of the manner in which and the terms under which each photoplay shall be distributed, exhibited and/or exploited, and all matters pertaining thereto, and the manner in which and the terms under which any of its rights may be sold or otherwise disposed of, including the right to adjust and settle all disputes with distributor or with any subsidiary, franchise holder licensee, exhibitor and/or other persons and we may deduct from the gross receipts the amounts necessary to settle any such claims, and you shall have no voice or control whatsoever in connection with the foregoing. We agree to use our best efforts in obtaining booking for any photoplay in which you are entitled to percentage, compensation at rentals consistent with the merit and boxoffice appeal of any such photoplay."

It is clear from the foregoing that the parties understood Republic had absolute ownership of the photoplays in controversy and that there was no restriction upon the exhibition. The same films used for televising are used in the exhibition of photoplays in conventional motion picture theatres, and that being true I must hold Republic's unrestricted ownership rights of the films include the right to license their exhibition on home television receivers. [See Vargas v. Esquire, Inc., 164 F. 2d 522; Lillie v. Warner Bros. Pictures, 139 Cal. App. 724, 34 P. 2d 835, 837; Gautier v. Pro-Football, Inc., 106 N. Y. S. 2d 553; Crimi v. Rutgers Presbyterian Church, 89 N. Y. S. 2d 813.]

I may also note each of the contracts in issue states that the law of California is to govern their construction,

but the sole California case cited (Lillie v. Warner Bros. Pictures, *supra*) would seem to preclude the discussion of matters beyond the contract itself. In Lillie v. Warner Bros. Pictures, *supra,* the District Court of Appeal of California stated:

"* * * By the contract respondent acquired a full ownership in the picture, subject only to the limitations contained in the contract. This ownership included the right to use the picture publicly in any form of exhibition, except as such right is limited by the terms of the contract. It seems clearly to follow that the exhibition of the scene as a short would not be a tortious invasion of the plaintiff's right of privacy. If wrong at all, it necessarily was only a breach of the contract."

Plaintiff urges that the televising of the subject photoplays is "commercial advertising." The evidence discloses that "spot advertising" is common practice in most conventional motion picture theatres. Television is also punctuated with advertisements. In principle there is no practical difference. The photoplay is exhibited as an "attention getter." In the theatre it is a "captured" audience; in the home television viewers have a number of stations from which they may select their entertainment. Theatres compete on the basis of the picture they are exhibiting. Television advertisers compete with each other by the type of entertainment offered for the attention of potential television addicts, thereby providing those advertisers the opportunity to bring their wares to the attention of the television audience.

Plaintiff is not in position to complain because "spot advertising" appears on television screens any more than he would have control over advertisements in the con-

(Autry District Court Opinion, cont.)

ventional theatre. The advertisements are independent of the photoplays. The close proximity of said advertisements to the photoplay is something beyond the control of the plaintiff. It is a matter of common knowledge that pictures intermingled with advertisements flow constantly over the television screen. It is difficult to segregate one sponsor from the other, except where the advertisement is interwoven into and made a part of a television picture.

I cannot see any merit to plaintiff's claim of unfair competition. He contracted with Republic for his part in the photoplay in question and was paid therefor. The fact he now has his own producing company and advertising business, does not destroy Republic's ownership of the photoplays or restrict its use of them. Plaintiff may not approve the televising of his old photoplays. He may not wish to be plagued by the ghosts of the past. It might just as well be said that plaintiff is competing with his old employer as to claim that his old employer is competing with him. Both stand in the same position.

Republic made a substantial contribution to plaintiff's present drawing power. That being true why should Republic be denied the fruits of the labor of both plaintiff and defendant and the plaintiff be the sole beneficiary? To me the plaintiff's position is not only untenable but unfair in attempting to prevent Republic from enjoying its full share of the profits to be derived from said photoplays.

It is a matter of common knowledge that radio, like newspapers and other advertising media, depends upon sponsors or advertisers for support. Only through such sponsors or advertisers could we maintain the freedom

of the radio or press. When television became a practical medium of communication and expression, it was recognized as a competitor of the screen, radio and the press, and, if it is going to be the product and a further bulwark of our free enterprise system, its programs must of necessity be sponsored by advertisers and accepted by them as a medium of advertising. It was in this climate that the 1942 and 1946 contracts were executed. To attempt now to graft on to the completed contracts additional restrictions, under the guise of unfair competition, that were not in contemplation of the parties at the time said contracts were executed, would, in my opinion, be manifestly unjust.

Plaintiff has introduced expert testimony in an attempt to demonstrate the harmful effect the televising of the photoplays involved will have upon his present activities. In my opinion such expert testimony is far-fetched, but even if true, it cannot affect the rights of Republic under the terms of its various contracts.

In this case parol testimony was offered and admitted not to vary the terms of the contract, but to explain the usage of various phrases as construed by the industry generally. No substantial evidence was offered indicating any ambiguity in the contracts. On the contrary the evidence indicates there was no ambiguity.

I was not concerned with the problem of a practical construction of the contracts for the reason that a present interpretation of said contracts was not sought until after the expiration and completion of those contracts.

Finally to boil this case down to substance, the plaintiff is seeking to prevent Republic from televising the photo-

(Autry District Court Opinion, cont.)

plays in which plaintiff starred, his complaint being that sponsored televising of a photoplay is "commercial advertising." Plaintiff is attempting to do indirectly what he knows he cannot do directly—*i. e.*, inducing the court to find that the present method of televising motion pictures is "commercial advertising." It is my view that television of motion pictures is a form of entertainment and not "commercial advertising."

As heretofore indicated, I find that the contracts place no restrictions upon Republic in the use of said films and that their contemplated use does not constitute unfair competition.

If plaintiff is worthy of his hire, certainly Republic is entitled to the full use of the fruits of his labor. [Sawyer v. Crowell Pub. Co., 46 F. Supp. 471, affirmed 142 F. 2d 497, Cert. Den. 323 U. S. 735; Grant v. Kellog Co., 58 F. Supp. 48, affirmed 154 F. 2d 59.]

Defendants are entitled to judgment and are directed to submit proposed findings and judgment in accordance with the opinions herein expressed.

Dated: This 13th day of May, 1952.

/s/ BEN HARRISON,
Judge.

[Endorsed]: Filed May 13, 1952.

In the United States District Court, Southern District of California, Central Division.

GENE AUTRY, *Plaintiff, vs.* REPUBLIC PRODUCTIONS, INC., a corporation, HOLLYWOOD TELEVISION SERVICE, INC., a corporation, etc., *Defendants.* No. 13596-BH.

FINDINGS OF FACT AND CONCLUSIONS OF LAW.

The above-entitled cause came on regularly for trial on and from March 11, 1952, to and including March 13, 1952, before the Court sitting without a jury. Plaintiff appeared by his attorneys Gang, Kopp and Tyre by Martin Gang and Milton A. Rudin; and defendants appeared by their attorneys Loeb and Loeb by Herman F. Selvin and Harry L. Gershon. Evidence both oral and documentary was received on behalf of the respective parties; the cause was duly argued by respective counsel and submitted to the Court for its decision; and the Court, having duly considered the same, now makes its Findings of Fact and Conclusions of Law herein as follows:

Findings of Fact.

I.

Plaintiff Gene Autry was at the time of the commencement of the within action and now is a citizen and resident of the County of Los Angeles, State of California.

II.

Defendant Republic Productions, Inc. (hereinafter referred to as "Productions") was at the time of the commencement of the within action and now is a corporation duly organized and existing under the laws of the State of New York, Defendant Hollywood Television Service, Inc. (hereinafter referred to as "Hollywood") was at the time of the commencement of the within action and

(Autry Findings, cont.)

now is a corporation duly organized and existing under the laws of the State of Delaware. Defendant Republic Pictures Corporation (sued herein as "Doe Corporation I" and hereinafter referred to as "Pictures") was at the time of the commencement of the within action and now is a corporation duly organized and existing under the laws of the State of New York.

III.

The amount in controversy herein exceeds the sum of $3,000.00, exclusive of interest and costs.

IV.

This Court has jurisdiction of the cause herein under and by virtue of section 1332 (1) of Title 28, U. S. Code. The jurisdiction of this Court over the third claim of the complaint is invoked under section 1331 of Title 28, U. S. Code.

V.

Defendants Hollywood and Productions, and each of them, are wholly owned subsidiaries of Pictures. The rights and liabilities of Hollywood and Pictures, and each of them, insofar as the subject-matter of this cause is concerned, are the same as and equal to the rights and liabilities of Productions. Wherever in these Findings and Conclusions reference is made to "Republic", said reference shall be deemed to and does include each and all of the aforementioned defendants.

VI.

Under date of September 4, 1934, plaintiff and Mascot Pictures Corporation entered into an agreement in writing, a copy of which is attached to the Pre-Trial Stipulation of Facts herein as Exhibit "A" thereof. Said agreement will be hereinafter referred to as the "1934 agreement."

(Autry Findings, cont.)

VII.

The 1934 agreement was assigned by Mascot Pictures Corporation to Productions on June 11, 1935. Subsequent to said assignment and pursuant to said 1934 agreement, plaintiff rendered services to Productions as an actor in the production of the following named motion pictures: Tumbling Tumbleweeds, Melody Trail, Sagebrush Troubadour, Singing Vagabond, Red River Valley, Comin' Round the Mountain, The Singing Cowboy, Guns and Guitars.

VIII.

Under date of July 8, 1936, plaintiff and Productions entered into an agreement in writing (hereinafter referred to as the "1936 agreement"), a copy of which is attached to the Pre-Trial Stipulation of Facts herein as Exhibit "B" thereto. Pursuant to said agreement, plaintiff rendered services to Productions as an actor in the production of the following named motion pictures: Oh Susanna, Roundup Time in Texas, The Old Corral, Ride Ranger Ride, The Big Show, Rootin' Tootin' Rhythm, Git Along Little Dogies, Singing' Kid from Pine Ridge, Public Cowboy Number One, Springtime in the Rockies, Boots and Saddle, The Old Barn Dance, Prairie Moon, Rhythm of the Saddle, Gold Mine in the Sky.

IX.

Under date of September 22, 1938, plaintiff and Productions entered into an agreement in writing (hereinafter referred to as the "1938 agreement"), a copy of which is attached to the Pre-Trial Stipulation of Facts herein as Exhibit "C" thereto. Pursuant to said agreement plaintiff rendered services to Productions as an actor in the production of the following named motion pictures:

(Autry Findings, cont.)

Home on the Prairie, Western Jamboree, Man from Music Mountain, Mexicali Rose, In Old Monterey, Colorado Sunset, Mountain Rhythm, Blue Montana Skies, South of the Border, Rovin' Tumbleweeds, Gaucho Serenade, Ride Tenderfoot Ride, Carolina Moon, El Rancho Grande, Ridin on a Rainbow, Melody Ranch, Back in the Saddle, The Singing Hills, Down Mexico Way, Under Fiesta Stars, Sunset in Wyoming, Sierra Sue, Cowboy Serenade, Heart of the Rio Grande, Home in Wyoming, Stardust on the Sage, Call of the Canyon, Bells of Capistrano.

X.

Under date of May 11, 1942, plaintiff and Productions entered into an agreement in writing (hereinafter referred to as the "1942 agreement"), a copy of which is attached to the Pre-Trial Stipulation of Facts herein as Exhibit "D" thereto. No motion pictures were produced and plaintiff rendered no services under or pursuant to said agreement.

XI.

Under date of February 1, 1946, plaintiff and Productions entered into an agreement in writing (hereinafter referred to as the "1946 agreement"), a copy of which is attached to the Pre-Trial Stipulation of Facts herein as Exhibit "E" thereto. Pursuant to said agreement, plaintiff rendered services to Productions in the production of the following named motion pictures: Trail to San Antone, Sioux City Sue, Twilight on the Rio Grande, Robinhood of Texas, Saddle Pals.

Principal photography on the last-named motion picture was completed and plaintiff's employment by Produc-

tions terminated on May 25, 1947. Wherever in these Findings or Conclusions reference is made to "said motion pictures," said reference shall be deemed to include all motion pictures produced by the Productions under the aforementioned agreements, in which plaintiff appeared, as set forth in Findings Nos. VII, VIII, IX and XI.

XII.

Plaintiff was not represented by an agent or attorney in the execution of the 1934 agreement, but was thereafter at all times represented by an actor's agent and legal counsel, and the 1936, 1938, 1942 and 1946 agreements were the product of joint negotiation and preparation by representatives of plaintiff and of Productions. Said agreements were from time to time modified by agreements in writing, but none of said modifications are in any particular material to the controversy herein.

XIII.

Each of said motion pictures was produced by Productions and released and distributed by Pictures and was distributed in interstate commerce. Each of said motion pictures was published with notice of copyright affixed and registered under the Copyright Laws of the United States in the Office of the Register of Copyrights by and in the name of Pictures as the copyright proprietor. Said publication and registration were in all cases made with the knowledge and consent and by the authority of Productions. Said copyrights, and each of them, are valid and subsisting, and plaintiff has no right, title or interest therein or in said motion pictures in which said copyrights have been secured. Defendants secured under said copyrights all rights in plaintiff's acts, poses, plays and appearances and the results and proceeds of plaintiff's ser-

(Autry Findings, cont.)

vices as same were reproduced in said motion pictures. Said motion pictures were not made solely for exhibition in motion picture theaters or solely for any other purpose, but were made for each and every purpose for which motion pictures have been, and are now or may be used, as more particularly hereinafter defined in Findings Nos. XIV and XXIV. Said motion pictures were and are suitable for, among other things, telecasting over home television receivers and for commercial advertising purposes, and will not be substantially changed or detrimentally altered by being shortened to 53½ minutes in length so as to permit their exhibition on a one-hour television program.

XIV.

Under and pursuant to the 1934, 1936, 1938, 1942 and 1946 agreements, the parties thereto intended to and did agree that, as between Productions and plaintiff, Productions owned and should own perpetually and exclusively, without restriction or limitation, all right, title and interest of every kind and character in and to said motion pictures, and each of them, produced and to be produced under said agreements, including, but not limited to, the following: the right to copyright and to assign to others the right to copyright said motion pictures; the right to distribute, transmit and exhibit and to license others to distribute, transmit and exhibit said motion pictures, or any of them, by any means or medium of distribution, transmission or exhibition of motion pictures then or now known or hereafter to be developed, and for any purpose for which motion pictures are now or may hereafter be distributed, transmitted or exhibited; and the right to cut, edit and otherwise revise and to license

others to cut, edit and otherwise revise said motion pictures at any time, whether before or after the first general release thereof, in any manner, to any length and for any purpose for which Productions might desire to distribute, transmit and exhibit or license others to distribute, transmit and exhibit said motion pictures.

Specifically, and without limiting the generality of the foregoing, the Court finds that the parties by said agreements intended to and did agree that Productions had and now has the perpetual, exclusive and unlimited right to transmit and exhibit said motion pictures by any means of television transmission now known or hereafter to be developed (including, but not limited to, transmission and exhibition thereof on home television receivers at no charge to the viewing audience), on television programs, whether such television programs are commercially sponsored or sustaining, and whether or not such television programs are telecast in connection with or for the purpose of advertising one or more commercial commodities, products and services of any kind or character whatsoever, and to cut and edit or to permit the cutting and editing of said motion pictures so as to allow in connection with such television programs, the insertion of one or more commercial advertisements of such commodities, products and services at the start of sach exhibition of said motion pictures, or any of them, at various intervals during said exhibition, and at the close of said exhibition.

XV.

The words "acts, poses, plays and appearances" and the words "name," "voice," and "likeness" or "physical likeness," as used in motion picture employment agreements, now have and since prior to September 4, 1934, have had

(Autry Findings, cont.)

a fixed, customary and usual meaning widely known and generally understood in the motion picture industry. Wherever said words, or any of them, were and are used in the 1934, 1936, 1938, 1942 and 1946 agreements, the parties to said agreements used and intended said words to be used in the sense in which they were and are customarily and usually understood and used in the motion picture industry, as more particularly defined in Findings Nos. XVI and XVII.

XVI.

The words "acts, poses, plays and appearances," as used in the 1934, 1936, 1938, 1942 and 1946 agreements, are and were customarily and usually understood in the motion picture industry, and were intended by the parties to said agreements, to mean and refer to the photography and recordation by motion picture camera and sound recording devices of the physical and vocal performances of the artist and the recordation thereof in and as a part of a motion picture or motion pictures.

XVII.

The words "name," "voice," and "likeness" or "physical likeness," as used in the 1934, 1936, 1938, 1942 and 1946 agreements, are and were customarily and usually understood in the motion picture industry, and were intended by the parties to said agreements, to mean and refer only to the artist's name, voice and physical likeness apart from and independent of the appearance thereof in or as a part of a motion picture or motion pictures.

XVIII.

Under and by virtue of the 1934, 1936, 1938, 1942 and 1946 agreements, and particularly paragraphs 9 of the first four agreements, and paragraph 8 of the last agree-

(Autry Findings, cont.)

ment, the parties thereto intended to and did agree that Productions owned and should continue to own, perpetually and exclusively and without any restriction or limitation whatsoever, all rights of every kind and character in and to the acts, poses, plays and appearances of plaintiff as hereinabove defined in Finding No. XVI, including, but not limited to, the right to exploit, distribute, transmit and exhibit same in the same manner, by the same means and media of transmission and distribution, and for the same purposes for which it had and has the right to exploit, distribute, transmit and exhibit said motion pictures, as that right is more particularly described and defined in Finding No. XIV.

For purposes of convenience and brevity, the right of Republic to exploit, distribute, transmit and exhibit and to license others to exploit, distribute, transmit and exhibit said motion pictures, or any of them, and plaintiff's acts, poses, plays and appearances therein, as said right is defined in Findings Nos. XIV and XVIII, shall hereinafter be referred to as Republic's "motion picture rights."

XIX.

Under and by virtue of the 1934, 1936, 1938, 1942 and 1946 agreements, plaintiff granted to Productions the right to use his name, voice and likeness as hereinabove defined in Finding No. XVII, for the purpose of and in connection with the advertising and exploitation of said motion pictures. The grant of said right to use plaintiff's name, voice and likeness was made and intended by the parties to be in addition to and independent of Productions' perpetual and unlimited rights in and to plaintiff's acts, poses, plays and appearances as set forth in Finding No. XVIII.

(Autry Findings, cont.)

XX.

Under and by virtue of said agreements, plaintiff retained and reserved the right to use and to license others to use his name, voice and likeness, independent of and apart from the appearance thereof in said motion pictures, for the purpose of and in connection with the advertising of commercial commodities, products and services of any and every kind and character. Pursuant to said reserved right, plaintiff from time to time since some time prior to 1934 licensed manufacturers or distributors of such commodities, products or services to use his said name, voice and likeness in connection with the advertising and exploitation of such commodities, products and services. Said licensing is and for many years has been productive of substantial revenue to plaintiff.

The right of Republic to use plaintiff's name, voice and likeness, as set forth in Finding No. XIX, and the rights reserved by plaintiff to the use thereof, as hereinabove set forth in this Finding, shall for purposes of convenience and brevity hereinafter be referred to as the "commercial advertising rights."

XXI.

The limitations upon Republic's commercial advertising rights as set forth in Finding No. XIX and the reservation of commercial advertising rights by plaintiff as defined in Finding No. XX were not intended and do not constitute any restriction or limitation whatsoever upon the exercise of Republic's perpetual and unlimited motion picture rights.

XXII.

Republic had and has not waived all or any part of its motion picture rights under the aforementioned agree-

(Autry Findings, cont.)

ments, and it is not estopped to assert all or any part of said rights.

XXIII.

On or about June 8, 1951, Hollywood offered in writing to various prospective licensees to license for television exhibition all or any number of said motion pictures. A copy of one of said written offers is attached to the Pre-Trial Stipulation of Facts herein as Exhibit "F" thereto. Said offers were all in substantially the same form and were made by the authority and with the consent of Pictures and Productions. It is the intention of Hollywood to license the television exhibition of said motion pictures by a form of License Agreement, a copy of which was offered and received in evidence as Plaintiff's Exhibit No. 29. Said offer has not been withdrawn. Said offer was not made maliciously or wilfully or in disregard of plaintiff's rights, nor was said offer made for any purpose other than the legitimate exploitation of Republic's rights in said motion pictures.

XXIV.

Said offer permits, but does not require, the transmission and exhibition of said motion pictures, or any of them, over home television receivers, free of charge to the viewing audience, on commercially sponsored or sustaining television programs. Said offer likewise permits, but does not require, the exhibition of said motion pictures, or any of them, as aforesaid, in connection with the advertising of one or more commercial commodities, products or services, in which exhibition the motion picture would be preceded and followed by one or more commercial advertisements of such commodities, products or services, and would be interrupted during the exhibition there-

(Autry Findings, cont.)

of at one or more times by such commercial advertisements, under and subject to the terms and conditions of paragraph 6 of the proposed license agreement. Said transmission and exhibition and the licensing thereof is and would be a permissible exercise of Republic's motion picture rights as more particularly defined in Finding No. XIV.

XXV.

Neither said offer nor the transmission and exhibition of said motion pictures thereunder nor the licensing thereof is or would be or constitute a breach of any of the terms or conditions of the 1934, 1936, 1938, 1942 and 1946 agreements, or any of them, or at all.

XXVI.

Plaintiff has achieved a world-wide reputation as "America's Favorite Cowboy" and as a western star of great fame and prominence. The joint efforts and expenditures of defendants and plaintiff in publicizing and exploiting the name and reputation of plaintiff, the photoplays produced by defendants in which plaintiff appeared, the world-wide release and distribution of the aforementioned photoplays by defendants, plaintiff's personality and ability, and his appearances in rodeos and other type of entertainment on radio and television, have all substantially contributed thereto, but it is not possible to estimate the amount or relative proportion of contribution of each.

XXVII.

It is a regularly established and recognized practice in the motion picture industry, and particularly in the distribution and exhibition of motion pictures, which practice has been established since prior to 1934, that the ex-

(Autry Findings, cont.)

hibition of motion pictures in theaters throughout the United States is accompanied by the advertising of motion pictures other than that then being exhibited, and by the advertising of commercial commodities, products and services other than motion pictures. Said practice has been followed in respect of various motion pictures in which plaintiff now appears or has heretofore appeared.

Republic has from time to time since June 11, 1935, conducted and licensed the conduct of a substantial number of non-theatrical exhibitions of said motion pictures, free of admission charge to the viewing audience, in schools, auditoriums, ships, churches, department stores, hospitals and the like, in both 35 mm. and 16 mm. gauge.

XXVIII.

Said exhibition of said motion pictures as hereinabove described in Finding No. XXVII is not distinguishable or different in substance from the proposed exhibition of said motion pictures, pursuant to Hollywood's offer of June 8, 1951, over home television receivers, as more particularly described in Finding No. XXIV.

XXIX.

The technique of transmission of said motion pictures over home television receivers and the visual effect of the exhibition thereof on the viewing audience are not distinguishable or different in substance from the technique of transmission and visual effect of exhibition of said motion pictures on the screen of a motion picture theater.

XXX.

The transmission and exhibition of said motion pictures, or any or all of them, on home television receivers, in connection with the advertising of one or more commer-

(Autry Findings, cont.)

cial commodities, products or services, in the manner more particularly described in Finding No. XXIV, whether said motion pictures are exhibited singly or in weekly blocks of 13, 26, 39 or 52, would not cause the viewing audience to believe that plaintiff or any other artist appearing in said motion pictures endorses or approves said commodities, products or services, or any of them, or to associate or identify plaintiff or any other artist appearing in said motion pictures with said commodities, products or services or the manufacturers thereof, or any of them. Said transmission and exhibition of said motion pictures, or any of them, would not be or constitute a use of plaintiff's name, voice or likeness for commercial advertising purposes and would not violate any of plaintiff's commercial advertising rights as hereinabove defined.

XXXI.

From the standpoint of both the advertiser and the viewing audience, the purpose, use and effect of the exhibition of a motion picture on home television receivers is not different or distinguishable in substance from the purpose, use and effect of such exhibition in a motion picture theater. To the advertiser, the motion picture is in both cases a means of assembling and holding an audience that, once assembled, can be subjected to his advertising message. To the viewing audience, the motion picture is in both cases a medium of entertainment, to view which it must recieve the advertiser's message.

XXXII.

The exercise of any or all of Republic's motion picture rights, as said rights are more particularly described in Findings Nos. XIV and XXIV, would not be or con-

(Autry Findings, cont.)

stitute unjust or unfair competition with plaintiff or infringe upon or otherwise unlawfully violate his commercial advertising or any other rights.

XXXIII.

The exercise of Republic's said motion picture rights in the manner alleged in the complaint is not and would not be contrary to commercial good faith or the normal and honorable development of the motion picture and television industries, would not cause confusion in the public mind or injury to plaintiff's name or reputation, is not and would not be a false description of goods with respect to their nature, origin or quality, and does not in any manner violate sections 1125 or 1126 of Title 15, U. S. Code, or plaintiff's rights under said sections.

XXXIV.

The 1934, 1936, 1938, 1942 and 1946 agreements, and each of them, are valid, binding and effective and all grants of rights thereunder are now in full force and effect.

XXXV.

The Court specifically makes no finding as to the truth or falsity of the allegations that plaintiff asserted and exercised the exclusive control over and right to the use of his name, voice and likeness, as more particularly defined in Finding No. XVII, for the reason that such a finding would be and is immaterial to any issues herein.

XXXVI.

The Court likewise and for the same reason set forth hereinabove in Finding No. XXXV makes no finding as to the truth or falsity of the allegations that the offer of June 8, 1951, as set forth in Finding No. XXIII was made with the knowledge that it would interfere with or

(Autry Findings, cont.)

damage plaintiff's commercial advertising business. The Court likewise makes no finding as to the truth or falsity of the allegations that the use of said motion pictures for television exhibition would or will inflict great and irreparable injury upon plaintiff, or would or will hinder him in obtaining employment on television or otherwise, or would or will destroy or dilute the commercial value of his recommendations or endorsement for advertising purposes.

Conclusions of Law.

I.

This Court has jurisdiction of the cause under and by virtue of section 1332(1) of Title 28 of the U. S. Code.

II.

The 1934, 1936, 1938, 1942 and 1946 agreements, and each of them, are valid, binding and effective and all grants of rights thereunder are now in full force and effect.

III.

As the owner of the copyrights in and to said motion pictures, Pictures has the sole and exclusive right under the copyright laws of the United States (17 U. S. C., sec. 1) to distribute, transmit and exhibit, or to license others to exploit, distribute, transmit and exhibit said motion pictures and plaintiff's acts, poses, plays and appearances herein in any manner or by any method whatsoever (as said right is more particularly defined in Findings of Fact Nos. XIV and XXIV.)

(Autry Findings, cont.)

IV.

As the employer of plaintiff under and by virtue of the aforesaid agreements by which plaintiff agreed to render services for and on behalf of Productions in, among other things, the production of motion pictures, Productions had and has sole and exclusive ownership of all the results and proceeds of said services rendered by plaintiff in the course of his employment by Productions, and likewise has the sole and exclusive right to sell, license or use, or to authorize or appoint others to sell, license or use said results and proceeds, for any purpose and in any manner whatsoever (as said right is more particularly defined in Findings of Fact Nos. XIV and XXIV).

V.

The aforesaid agreements, and each of them, specifically recognize, without any limitation or restriction, that Pictures and Productions have and at all times mentioned herein had, as against the plaintiff, the right to exploit, distribute, transmit and exhibit said motion pictures in any manner or by any method now or hereafter devised or constructed (as said right is more particularly defined in Findings of Fact Nos. XIV and XXIV) and to appoint Hollywood their agent to license such exploitation, distribution, transmission and exhibitation of said motion pictures in like manner and for like purposes.

(Autry Findings, cont.)

VI.

Whatever rights in said motion pictures are owned by any of the above-named defendants are owned and, as against plaintiff, may be exercised by any or all of said defendants.

VII.

Defendants, and each of them, are entitled to a judgment declaring their rights and duties in respect of the controversy herein as hereinabove in these conclusions expressed, and adjudging that plaintiff take nothing by his Complaint on file herein and that said Complaint be dismissed on the merits with defendants' costs incurred herein, and that defendants have execution for said costs.

Let judgment be entered accordingly.

Dated: Aug. 18, 1952.

/s/ BEN HARRISON,
District Judge.

(Disapproved) as to form under Local Rule 7. Received June 14, 1952, at 5:00 p. m.

GANG, KOPP AND TYRE,
/s/ By MILTON A. RUDIN,
Attorneys for Plaintiff.

[Endorsed]: Filed Aug. 18, 1952.

In the United States District Court, Southern District of California, Central Division.

GENE AUTRY, *Plaintiff, vs.* REPUBLIC PRODUCTIONS, INC., a corporation, HOLLYWOOD TELEVISION SERVICE, INC., a corporation, etc., *Defendants.* No. 13596-BH.

JUDGMENT FOR DEFENDANTS.

The above-entitled cause came on regularly for trial on and from March 11, 1952, to and including March 13, 1952, before the Court sitting without a jury. Plaintiff appeared by his attorneys, Gang, Kopp and Tyre by Martin Gang and Milton A. Rudin; and defendants appeared by their attorneys Loeb and Loeb by Herman F. Selvin and Harry L. Gershon. Evidence both oral and documentary was received on behalf of the respective parties; the cause was duly argued by respective counsel and submitted to the Court for its decision; and the Court, having duly considered the same and having made and filed its Findings of Fact and Conclusions of Law herein,

Now, therefore,

It is hereby ordered, decreed and adjudged that the rights of the parties hereto in respect of the controversy alleged in the complaint on file herein are, and are hereby declared to be as follows:

Defendants, and each of them, own and are entitled to exercise, solely and exclusively, without restriction or limitation, all right, title and interest of every kind and character in and to the following named motion pictures (including plaintiff's acts, poses, plays and appearances therein), including, but not limited to, the following: The right to copyright and to assign to others the right to copyright said motion pictures; the right to distribute,

(Autry Judgment, cont.)

transmit and exhibit and to license others to distribute, transmit and exhibit said motion pictures, or any of them, by any means or medium of distribution, transmission or exhibition of motion pictures now known or hereafter to be developed, and for any purpose for which motion pictures are now or may hereafter be distributed, transmitted or exhibited; the right to cut, edit and otherwise revise and to license others to cut, edit and otherwise revise said motion pictures at any time, whether before or after the first general release thereof, in any manner, to any length and for any purpose for which they may desire to distribute, transmit and exhibit or license others to distribute, transmit and exhibit said motion pictures; and the perpetual, exclusive and unlimited right to transmit and exhibit said motion pictures by any means of television transmission now known or hereafter to be developed (including, but not limited to, transmission and exhibitions thereof on home television receivers at no charge to the viewing audience), on television programs, whether such television programs are commercially sponsored or sustaining, and whether or not such television programs are telecast in connection with or for the purpose of advertising one or more commercial commodities, products and/or services of any kind or character whatsoever, and to cut and edit or to permit the cutting and editing of said motion pictures so as to allow the insertion in connection with such television programs, of one or more commercial advertisements of such commodities,

(Autry Judgment, cont.)

products and services at the start of each exhibition of said motion pictures, or any of them, at various intervals during said exhibition, and at the close of said exhibitions: Tumbling Tumbleweeds, Melody Trail, Sagebrush Troubadour, Singing Vagabond, Red River Valley, Comin' Round the Mountain, The Singing Cowboy, Guns and Guitars, Oh Susanna, Roundup Time in Texas, The Old Corral, Ride Ranger Ride, The Big Show, Rootin' Tootin' Rhythm, Git Along Little Dogies, Singin' Kid from Pine Ridge, Public Cowboy Number One, Springtime in the Rockies, Boots and Saddle, The Old Barn Dance, Prairie Moon, Rhythm of the Saddle, Gold Mine in the Sky, Home on the Prairie, Western Jamboree, Man from Music Mountain, Mexicali Rose, In Old Monterey, Colorado, Sunset, Mountain Rhythm, Blue Mountain Skies, South of the Border, Rovin' Tumbleweeds, Gaucho Serenade, Ride Tenderfoot Ride, Carolina Moon, El Rancho Grande, Ridin on a Rainbow, Melody Ranch, Back in the Saddle, The Singing Hills, Down Mexico Way, Under Fiesta Stars, Sunset in Wyoming, Sierra Sue, Cowboy Serenade, Heart of the Rio Grande, Home in Wyoming, Stardust on the Sage, Call of the Canyon, Bells of Capistrano, Trail to San Antone, Sioux City Sue, Twilight on the Rio Grande, Robinhood of Texas, Saddle Pals.

It is further hereby ordered, decreed and adjudged that plaintiff take nothing by reason of his Complaint on file herein; that said Complaint be and it is hereby dismissed on the merits; and that defendants have and recover

(Autry Judgment, cont.)

from plaintiff their costs incurred herein, and that defendants have execution therefor. Costs taxed at $1183.61.

Dated: August 18, 1952.

/s/ BEN HARRISON,
District Judge.

(Disapproved) as to form under Local Rule 7. Received June 14, 1952, at 5:00 p.m.

GANG, KOPP AND TYRE,
/s/ MILTON A. RUDIN,
Attorneys for Plaintiff.

[Endorsed]: Filed Aug. 18, 1952.

United States Court of Appeals
For the Ninth Circuit.

REPUBLIC PICTURES CORPORATION, REPUBLIC PRODUCTIONS, INC., and HOLLYWOOD TELEVISION SERVICE, INC., *Appellants,* vs. ROY ROGERS, *Appellee.* No. 13,314, Jun. 4, 1954.

Appeal from the United States District Court for the Southern District of California, Central Division.

Before: HEALY, BONE and POPE, Circuit Judges.

BONE, Circuit Judge.

This is an appeal from a judgment of the United States District Court for the Southern District of California, Central Division, enjoining appellants from distributing or licensing the exhibition of eighty-one motion pictures produced and owned by them upon sponsored or sustaining television programs. In each of those motion pictures appellee appears as the principal actor. Appellants claim the right, under contracts with appellee, to freely exhibit motion pictures produced pursuant to such contracts, on television or by any other means, regardless of whether advertising is connected with such exhibitions. All parties agree that pursuant to said contracts, appellee and only appellee has the right to use his name, picture or voice in advertisements (except for advertisements of motion pictures). Appellee contends that the exhibition of motion pictures in which appellee is the leading actor, upon commercially sponsored television programs, would be an advertising use of his name, picture and voice, a right not granted by the said contracts. Necessarily we must commence our study of this conflict by examining the contractual provisions which bear upon the controversy.

(Rogers Opinion, cont.)

Only two contracts are involved, one executed in 1937, and the other in 1948. The pertinent parts of these contracts are excerpted as follows:

The 1937 contract, paragraph 4: "The artist expressly gives and grants to the producer the sole and exclusive right to photograph and/or otherwise reproduce any and all of his acts, poses, plays and appearances * * * during the term hereof * * *; and further gives and grants to the producer solely and exclusively all rights of every kind and character whatsoever in and to the same, or any of them, perpetually, including as well the perpetual right to use the name of the artist and pictures or other reproductions of the artist's physical likeness, and recordations and reproductions of the artist's voice, in connection with the advertising and exploitation * * *. The artist does also hereby grant to the producer, during the term hereof, the sole and exclusive right to make use of, and to allow others to make use of, his name for advertising, commercial and/or publicity purposes (other than in connection with the acts, poses, plays and appearances of the artist hereunder), as well as the sole and exclusive right to make use of and distribute * * * his pictures, photographs or other reproductions of his physical likeness and of his voice for like purposes."

The 1948 contract, paragraph 4: "(A) The Artist hereby grants to Producer the sole and exclusive right to his services for motion picture purposes during the term hereof * * * to photograph and/or otherwise reproduce any and all of his acts, poses, plays and appearances * * * and to record his voice and all instrumental, musical and other sound effects produced by him * * * The Artist also grants to the Producer, solely and exclusively,

(Rogers Opinion, cont.)

all rights of every kind and character whatsoever in and to all such photographs, reproductions and recordings and all other results and proceeds of his services hereunder, perpetually, and also the perpetual right to use the Artist's name and pictures or other reproductions of his physical likeness and recordations and reproductions of his voice, in connection with the advertising and exploitation thereof * * *.

"(B) For the purpose of advertising the photoplays to be produced hereunder, and subject to the reservations set forth in Subparagraph (C) of this Paragraph 4, the Artist also hereby grants to the Producer the right, during the term hereof, to use and/or authorize the use of his name and/or likeness in so-called 'commercial advertising,' to wit, advertising relating to products other than motion pictures, [subject to a number of limitations.]

"(C) The Artist reserves to himself the right to enter into any and all commercial tie-ups for products of every kind or character (other than motion pictures) * * *."

It will be noted that these contracts use two different sets of descriptive words, not common in most contracts nor in ordinary parlance. They are (1) "acts, poses, plays and appearances" and (2) "name, voice and likeness." If these two sets of descriptive words mean one and the same thing, then appellants must probably be denied the result which they seek here, for it is clear to appellants, to appellee and to us that any contractual right which appellants had, to the use of appellee's "name, voice or likeness," in advertising anything other than the motion pictures, expired with the expiration of the contracts. The only issue would then be whether the proposed ex-

(Rogers Opinion, cont.)

hibition of these films would be an advertising use of appellee's name, voice and likeness.

But if those two sets of descriptive words mean two entirely different things, then any restriction upon one need not necessarily have any relation to rights to the other. It is appellants' contention that "acts, poses, plays and appearances" refer to the embodiment of appellee's services in the motion pictures where he appears, acts, poses and plays. Appellants distinguish the use of the product and reproduction of his acts, poses, plays and appearances in motion pictures, from the use of appellee's name, likeness and voice apart from their embodiment in motion pictures.

On their face, these contracts purport to be California contracts and that fact is not disputed. Being a diversity of citizenship case, the contracts will be interpreted so as to reach the same results as would be reached in a California court. Erie R. R. Co. v. Tompkins, 304 U. S. 64; Sampson v. Channel, 1 Cir., 110 F. 2d 754. In ascertaining whether or not these contracts are ambiguous, as found by the trial court, and in interpreting the contracts, this court is not bound by the findings of the trial court for in those matters we are principally concerned with questions of law. Brown v. Cowden Livestock Co., 9 Cir., 187 F. 2d 1015, 1018; Plomb Tool Co. v. Sanger, 9 Cir., 193 F. 2d 260, 264.

The focal point of this case does not involve any difficult questions of California law; rather, the principal points of reference in that law are quite well laid out. The statutory rules regarding interpretation of contracts are set forth in Calif. Civ. Code §§1635-1662. We make particular reference to §1638 ("The language of a con-

tract is to govern its interpretation, if the language is clear and explicit, and does not involve an absurdity"), §1641 ("The whole of a contract is to be taken together, so as to give effect to every part if reasonably practicable, each clause helping to interpret the other"), §1645 ("Technical words are to be interpreted as usually understood by persons in the profession or business to which they relate, unless clearly used in a different sense"), §1650 ("Particular clauses of a contract are subordinate to its general intent") and to §§1856, 1857, and 1858 of the Calif. Code of Civ. Proced.

In applying the noted code sections and related law, the California appellate courts have made it abundantly clear that when parties set forth their agreement, as was done in this case, in a contract which attempts to cover all of their relationships in the business involved, these rules apply: (1) the interpretation to be given a contract is determined as a matter of law solely from the instrument itself if that can possibly be done without making any part of the instrument nugatory, or reaching an absurdity, and an appellate court is free to adopt its own construction, Moss Construction Co. v. Wulffsohn, 1953, 116 Cal. App. 2d 203, 205; Miranda v. Miranda, 1947, 81 Cal. App. 2d 61, 66-67; (2) the contract must be taken by its four corners, and read so as to effectuate every part, if that may reasonably be done, Kohn v. Kohn, 1950, 95 Cal. App. 2d 708, 713; Miranda v. Miranda, *supra;* (3) and particularly, courts are loathe to impose limitations or restrictions upon the parties which are not expressly contained in their agreement or which do not arise by necessary implication, and without such implied restrictions the contract could not be effectively performed,

(Rogers Opinion, cont.)

Tanner v. Title Ins. & Trust Co., 1942, 20 Cal. 2d 814, 824; Stockton Dry Goods Co. v. Girsh, 1951, 36 Cal. 2d 677, 679; Hoops v. Tate, 1951, 104 Cal. App. 2d 486, 487; Sharpe v. Arabian American Oil Co., 1952, 111 Cal. App. 2d 99, 102. See also Williston on Contracts, vol. 5, §1293.

In both the 1937 and 1948 contracts involved herein, the parties contracted with respect to a number of different and separate rights, using separate and distinct phrases which apparently seemed apt to the parties at the time, to separately designate those rights. The subject matter of those rights was (1) photography and reproduction of the artist's "acts, poses, plays and appearances"; (2) ownership of the products of that photography; (3) use of the "name, voice and likeness" of the artist in advertising and exploiting the products of the photography; and (4) use of the "name, voice and likeness" of the artist in advertising commercial products other than the products of the photography. Each of these matters is separately provided for, and the terminology, as above indicated, is consistently used so as to maintain the distinction. Taking the instruments as a whole, it seems clear to us that "acts, poses, plays and appearances" has reference to the activities of the artist in connection with the motion pictures which it was the main purpose of these agreements to facilitate; whereas "name, voice and likeness" has reference to non-motion picture reproductions of characteristics of the artist, which last said reproductions themselves are valuable because of the notoriety of the artist and his great public following. But express restrictions upon the producer in his use of any particular right cannot by subsequent implication be

(Rogers Opinion, cont.)

read into separate and distinct rights as a restriction upon them.

We are not called upon to delineate the nature of the restrictions upon appellants' use of the artist's "name, voice and likeness" (according to the meaning herein indicated) in commercial advertising. Those limitations are not in dispute, once we distinguish the subject matter to which they apply from appellants' rights to the artist's "acts, poses, plays and appearances." We are called upon to settle the uses, at least in part, which appellants may make of the motion pictures containing appearances of the artist, which are owned by appellants. Appellee, the artist, was paid full measure for his services in creating these films, and has specifically relinquished "all rights of every kind and character whatsoever in and to the same * * * perpetually." We are bound to give effect to the meaning of that agreement, that grant, and are bound not to cut it down by implication from another grant unless it is necessary to the effective operation of the contract. Tanner v. Title Ins. & Trust Co., *supra*. We therefore hold that appellants may exercise their ownership and rights to the product of artist's employment, whether or not such exercise involves exhibition of the subject motion pictures in connection with commercial advertising. The restrictions which involved advertising were restrictions upon the use of artist's "name, voice and likeness," not upon appellants' use of artist's "acts, poses, plays and appearances" or the product thereof.

The fact that artist's name, his voice, and his likeness are contained in and throughout the motion pictures in which he appears is superficially confusing. That is why it is necessary to read the whole of the contracts, and read

(Rogers Opinion, cont.)

each part in relation to the other parts. Kohn v. Kohn, *supra;* Miranda v. Miranda, *supra.* Upon such reading, it very soon becomes clear that the words are used definitively, and that the distinction hereinbefore set forth was clearly contained in the agreements.

A number of additional issues have been raised in this case, all of which are predicated upon an interpretation of the contracts at variance with the meaning as stated herein. If the unlimited grant to appellants of the product of the appellee's services were limited by the subsequent references to advertising uses of appellee's name, voice and likeness, then appellants might be further or otherwise limited in the use of appellee's name, voice, or likeness by waiver or estoppel. But since the two sets of rights are distinct, any waiver or estoppel as to the latter cannot affect the former. Whether the proposed use of the motion pictures by appellants would be unfair competition with appellee if the agreements were silent with respect to appellants' rights, or if the agreements reserved or granted to appellee rights to the motion pictures or advertising uses of them, are questions no longer an issue. Appellee having expressly consented to the proposed use by appellants, he cannot now contend that appellants' use will be unfair competition with him. Vargas v. Esquire, Inc., 7-Cir., 164 F. 2d 522, 526-527; Lillie v. Warner Bros. Pictures, 139 Cal. App. 724, 728; R.C.A. Mfg. Co. v. Whiteman, 2-Cir., 114 F. 2d 86, 90.

It follows that the judgment of the lower court must be reversed and the cause remanded with directions to enter judgment for defendants.

(Endorsed:) Opinion. Filed Jun. 4, 1954.

Paul P. O'Brien, Clerk.

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IN THE

Supreme Court of the United States

October Term, 1954.

No. 315.

GENE AUTRY,

Appellant and Petitioner,

vs.

REPUBLIC PRODUCTIONS, INC., a corporation, HOLLYWOOD TELEVISION SERVICE, INC., a corporation, and REPUBLIC PICTURES CORPORATION, a corporation,

Appellees and Respondents.

BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI.

Preliminary Statement.

Except for the Lanham Act question (which it was not necesary for either the District Court or the Court of Appeals to reach, see Point II, *infra*) this is a diversity case, governed entirely by the law of the state of California in which it arose. The principal item of dispute in this case, settlement of which is determinative of the entire controversy, relates to the correct interpretation of a series of employment contracts between the parties—obviously a question wholly governed by state law. There is, however, not the slightest suggestion in the petition that there was "decided an important state or territorial question in a way in conflict with applicable state or

territorial law. . . ." [U. S. S. C. Revised Rules (1954), rule 19(b).] Instead, again excepting the Lanham Act question, reliance is placed on the claim that petitioner's count for a declaratory judgment was overlooked below, thus evincing such a departure "from the accepted and usual course of judicial proceedings . . . as to call for an exercise of this court's power of supervision." [U. S. S. C. Revised Rules (1954), rule 19(b).]

Here it is petitioner who overlooks the incontestable fact that the District Court expressly and at length *declared the rights and duties of the parties* in its judgment [R. 280-281]; and that the Court of Appeals, with one modification *which the petitioner requested*, affirmed that judgment. [R. 723-725; Pet. App. 3-5.] It is only to the correctness of that slight modification and the extent to which it should have gone that any review is asked by petitioner. It is obvious, therefore, that the prayer for a declaratory judgment was not overlooked and that there was no departure from the accepted and usual mode of proceedings. What is really sought by petitioner, it thus becomes plain, is a further review of the *correctness of the declaration which was made below* in respect of only one part, and that a minor and collateral part, of the controversy.

We realize, of course, that this Court's discretion in acting upon a petition for certiorari is not always or inexorably confined by its rules. For any relaxation of those rules, however, there surely must be some urgent and pressing *public* importance [*N. L. R. B. v. Pittsburgh S. S. Co.*, 340 U. S. 498, 502; *Layne & Bowler Corp. v. Western Well Works*, 261 U. S. 387] which is not made out in the case at bar. Certainly it is not made out by

what amounts to no more than a request by "the defeated party in the Circuit Court of Appeals [for] another hearing. . . ." [*Magnum Import Co. v. Coty*, 262 U. S. 159, 163.]

So far as the Lanham Act question is concerned, it was necessarily disposed of when the basic contract controversy was determined. The gist of the Lanham Act contention made by petitioner was and is that there is now a Federal law of unfair competition; that what will constitute unfair competition is to be determined by certain treaties which thereby have the effect, as a matter of domestic law, of proscribing any act contrary to commercial good faith or to the normal and honorable development of business activities, as well as the more traditional acts of confusion of source and palming-off; and that without plaintiffs' consent and without any right otherwise so to do, television exhibition of the motion pictures in which petitioner appeared would, in that definition, constitute unfair competition with his so-called commercial advertising business. [R. 22-23; Pet. 6, 9, 15, 19-21.]

When, however, both the District Court and the Court of Appeals determined that petitioner, by his contracts with respondents, had agreed and consented to the exercise of the television rights claimed by the latter, and found as facts that exercise of those rights would not constitute unfair competition, be contrary to commercial good faith or the normal and honorable development of the motion picture and television industries, would not injure petitioner's name or reputation, would not cause any confusion of source or origin, and would not be a false description of the goods [R. 265-275], they rendered it wholly unnecessary to do any more with the Lanham

Act question than to hold, as both courts did, that that question was concluded by this basic determination. [R. 275, 724.]

Questions Presented.

1. In a case involving respondents' right to televise motion pictures owned by them, injunctive and declaratory relief was sought to prevent televising and, in connection with such televising, the shortening of the pictures so as to enable them to be exhibited with advertising within the confines of a one-hour program. The District Court, in denying that relief, found, not only that respondents had the specific right to shorten the pictures to the extent and for the purpose pleaded and proved, but also that they had the general right to cut, edit and revise them in any way, to any length and for any purpose. The pleading and evidence related only to the specific rather than the general right. In those circumstances was it a departure from the accepted and usual course of proceedings for the Court of Appeals to order modification of the judgment so as to eliminate the general finding, thus confining adjudication to the specific issue actually pleaded and proved?

2. It being contended by petitioner and denied by respondents that the Lanham Act [15 U. S. Code, sec. 1126] has the effect of establishing a Federal law of unfair competition and that it adopts as a definition of the practices which it proscribes the provisions of certain treaties in that regard, is it necessary or proper to decide that question when, upon findings concurred in by both the District Court and the Court of Appeals, the existence of the facts which would bring the case within that definition is expressly negated?

Statement of the Case.

1. While, for the sake of completeness and the correction of certain misstatements, there is needed a more pointed and extended summary of the pleadings and facts of this case than petitioner has presented, the specific and narrow points which he raises in his petition may be disposed of with a fairly brief statement.[1]

2. The controversy here arises out of the relationship of employer and employee which for several years existed between Republic and petitioner;[2] more specifically, out of their divergent views as to the meaning and effect of the contracts by which that relationship was created and governed. [R. 223.]

3. Petitioner was employed by Republic to render services as an actor in motion pictures to be produced by the latter. [R. 213-215, 261-264.] The employment contracts all provided that the results of those services, his "acts, poses, plays and appearances" as recorded and depicted in those pictures, should belong exclusively and perpetually to Republic. [R. 51-53, 79-80, 96, 108-109, 143-144, 170-171.] In addition, each of the contracts provided that Republic should have perpetually the right to use petitioner's "name, voice and likeness" for purposes of advertising the pictures and, for a limited time and subject to varying conditions, the right to use or permit others to use his name, voice and likeness to advertise

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[1]If a more detailed summary is felt to be desirable, one will be found as an appendix to this brief.

[2]For convenience the respondents are collectively referred to as "Republic." Their positions in the litigation and their rights as against petitioner require no differentiation *inter se*.

other products. [R. 53, 61-62, 80, 108-109, 144, 171, 517-523, 542-543.]

4. Each of the contracts also provided, in substantially the same language, that the term "motion pictures" as used therein meant "motion pictures produced, exhibited with and/or accompanied by . . . *television* and all other improvements and devices which are now or which may hereafter be used in connection with the production, exhibition and/or transmission of any present or future kind of motion picture productions. . . ." [R. 126-127, 63-64, 96, 160-161, 163. Italics ours.]

5. Some fifty-seven motion pictures were produced under these contracts. Republic, as the proprietor thereof, duly copyrighted each of them. [R. 215, 264-265.] In 1951, Republic offered to license certain of these pictures for television exhibition. Petitioner thereupon asserted that this use of the pictures would be a use of his name, voice and likeness to advertise products other than the motion pictures, which Republic had no right to do. Republic, on the other hand, insisted that it was merely using the recordations of petitioner's "acts, poses, plays and appearances" as to which it had all rights in any and every medium of exhibition. That joinder of the basic issue was at all times the crux of this litigation.

6. Petitioner sought to prevent Republic's proposed use of its pictures by a complaint in which he asked for an injunction, and a declaration as to whether Republic had television rights under the contracts. [R. 3-22.] Upon the same allegations he also sought injunctive relief under the Lanham Act. [R. 22-23.] The District Court found the contracts to mean what Republic had contended they meant and denied injunctive relief. [R. 265-270,

277-279.] It also denied relief under the Lanham Act because, whatever might be the effect of that legislation as establishing a Federal code of unfair competition and assuming it went as far as petitioner claimed, the facts which were found to be true did not make out any violation of the statute. [R. 275, 236-237.] Conformably to this determination, the District Court declared that Republic had the television rights claimed by it. The Court also declared, generally, that Republic had the right to cut, edit and alter the pictures in any way it desired [R. 280-281]; and, specifically, that it had the right to shorten them to a running time of 53½ minutes in order to permit of their exhibition on a one-hour television program with interpolated advertising. [R. 265.]

7. (a) In view of petitioner's contentions in respect of this issue of editing, it becomes necessary to notice exactly how it became an element in the litigation. There are only two references to cutting or editing in the pleadings. The first of these is found in the count for injunctive relief. There, in the course of a general allegation of the conduct on Republic's part which it was sought to enjoin, it is averred that Republic had caused or was offering to cause the pictures to be shortened "to a length of only approximately 53 minutes and to be interrupted at several intervals during the showing of said motion picture so as to permit the insertion in a one-hour television program of approximately 7 minutes of advertising material for the purpose of advertising the product or products of the sponsor or sponsors of such television program." [R. 9.]

(b) The second reference is in the declaratory relief count. There, as part of the general controversy between

the parties in respect of which a declaration was desired, it was alleged that Republic claimed the right to license the pictures "for exhibition over home television receivers or for the purpose of commercial advertising *and in connection therewith* to cut, alter or rearrange said motion pictures and interpolate therein commercial advertising all without the consent of plaintiff." [R. 16-17. Italics ours.]

(c) The *only evidence* relating to this issue consisted of the fact that the pictures were being or would be shortened to 53½ minutes from their original running time of about 65 minutes, along with a description of how this was being done. [R. 41, 577-579.] From that evidence the District Court found (and the finding is not challenged here) that the pictures "will not be substantially changed or detrimentally altered by being shortened to 53½ minutes in length. . . ." [R. 265.]

8. The District Court also found that Republic had "the right to cut, edit or otherwise revise . . . said motion pictures at any time . . . in any manner, to any length or for any purpose. . . ." [R. 266.] In the Court of Appeals the petitioner contended that this finding was too broad. That Court agreed, and ordered modification (not complete *deletion* as petitioner claims) so as to restrict decision to the only issue before the court in that regard, *i. e.*, the right to cut to 53½ minutes. [R. 723-725; Pet. App. 3-4.] In all other respects the Court of Appeals affirmed. [R. 721-725; Pet. App. 1-5.]

9. On the basic and decisive question which was before the courts below—the true meaning and legal effect of the contracts in respect of the right to exhibit the pictures by television—petitioner seeks no review here.[8] He confines himself to the incidental and collateral issue of the proper scope of the declaration which should have been made regarding the right to cut or edit, and to the question of the applicability of the Lanham Act. [Pet. 5-6, 15-16.] We shall, therefore, follow his example and limit our reply to those two questions, discussing them, as they now must be discussed, on the assumption (with which both courts below agreed) that Republic does have the right to exhibit these pictures on television, either with or without accompanying advertising, and that to this end it may cut the pictures to 53½ minutes so that they may be exhibited within the limits of the conventional one-hour program.

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[8]We are not unmindful of the fact that petitioner has perfunctorily touched upon this question. He does so, however, by a mere reference to the existence of a similar question in *Rogers v. Republic Pictures Corp.*, Oct. Term, 1954, No. 314, in which a petition has also been filed. [Pet. 16, 21.] He offers no argument in support of his position on that issue. He makes no attempt to show how it arises on *this* record; and whether, if it does arise, it is in the same posture, factually and procedurally, as it is in No. 314. Furthermore, *he does not include it in his list of questions presented.* In these circumstances we submit that the issue has not been properly raised or presented. [*Cf., Connecticut Ry. & L. Co. v. Palmer*, 305 U. S. 493, 496-497; *United States v. Penn Foundry & Mfg. Co.*, 337 U. S. 198, 205 (Note 1); *U. S. S. C. Revised Rules* (1954), Rule 23, 1, (c).

ARGUMENT.

I.

The Court of Appeals Did Not Depart From the Usual and Accepted Course of Procedure. It Merely and Properly Confined the Findings and Judgment to the Issues Made by the Pleadings and Evidence.

Petitioner's argument in support of his contention of departure from the usual and accepted course of procedure comes down to the proposition that notwithstanding his request for a declaration "as to the limitations and restrictions, if any, on Republic's right to cut, revise and edit the motion pictures" the Court of Appeals deleted all reference to this subject from the judgment, thus leaving an important issue undecided. [Pet. 5-6, 15, 16-18.] There are several answers to this proposition.

First: The Court of Appeals did not delete all reference to this issue from the findings or judgment. What it did do was to modify the District Court's broad determination that Republic had the right to cut, alter or edit as it saw fit, so as to confine it to the *only issue* in that respect tendered by the pleadings and evidence. [R. 723-724, 725; Pet. App., 3-4.]

As we have seen [*Statement of the Case*, par. 7, *supra*] there were only two references to cutting and editing in the pleadings. One of these was the allegation that Republic proposed to cut the pictures to 53 minutes to permit of the interpolation of advertising; which allegation was designed to define, to that extent, the conduct

against which an injunction was sought. [R. 9.] The other was the allegation that the controverted subject in respect of which a declaration was desired was Republic's assertion of a right to televise the pictures and in connection therewith to cut them so as to permit the interpolation of advertising. [R. 16-17.] The evidence conformed to the limited scope of these allegations. At no time was there a tender of the broad issue of how far the right to edit extended, beyond the particular type of editing pleaded and proved.

In so confining adjudication to the issues actually made by the pleadings and evidence the Court of Appeals followed rather than departed from the usual and accepted course of proceedings. [*Saulsberry v. Maddix,* 6 Cir., 125 F. 2d 430, 436, *cert. den.* 217 U. S. 643; *Equitable Trust Co. v. Denver & R. G. R. Co.,* 2 Cir., 250 Fed. 327, 340-341, *cert. den.* 246 U. S. 672; *Bayne v. United States,* 8 Cir., 195 Fed. 236, 240-241; *Mason City etc. R. Co. v. Boynton,* 8 Cir., 158 Fed. 599, 601; *Hartung v. Hilda Miller, Inc.,* App. D. C., 133 F. 2d 401, 402. *Cf., United States v. Crescent Amuse. Co.,* 323 U. S. 173, 185-187.]

Second: No declaratory relief with respect to the matter of cutting and editing was ever requested. The allegation in that regard found in the declaratory judgment count was not offered as a separate item of controversy as to which rights and duties were to be declared; it was pleaded merely as an incident of Republic's claimed right to televise. [See, our Appendix, Note 3.] That is

clear enough from the form of the allegation itself. [See, *Statement of the Case,* par. 7(b), *supra.*] It is made unmistakably plain by the petitioner's prayer, in which *no declaration of the sort now asserted was requested.* That exact request was only for a declaration that the contracts were invalid, and, if valid, that no right to televise the pictures was granted thereby. [R. 24-25, pars. 5, 6.]

Third: The Court of Appeals was quite right in its disposition of this issue. It is the general rule—the usual and accepted course of proceeding—not to grant an injunction against acts not threatened or likely to occur. [*Connecticut v. Massachusetts,* 282 U. S. 660, 674, and cases there cited; *New York v. Illinois,* 274 U. S. 488; *Public Service Comm. v. Wycoff Co.,* 344 U. S. 237, 240-241; *New Standard Pub. Co. v. Federal Trade Comm.,* 4 Cir., 194 F. 2d 181, 183; *City of Seattle v. Puget Sound etc. Co.,* 9 Cir., 284 Fed. 661, 662-663, *cert. den.* 262 U. S. 743.] Similarly, it is the general rule not to render a declaratory judgment in respect of hypothetical situations which may never arise. [*Coffman v. Breeze Corporations, Inc.,* 323 U. S. 316, 323-324, and cases there cited; *Ashwander v. Tennessee Valley Authority,* 297 U. S. 288, 324-325; *Public Service Comm. v. Wycoff Co., supra,* 344 U. S. at 241-243; *Caterpillar Tractor Co. v. International H. Co.,* 9 Cir., 106 F. 2d 769, 772, 773; *State Mut. L. Assur. Co. v. Webster,* 9 Cir., 148 F. 2d 315, 319.]

Here, the only threatened act, the only concrete situation which had actually arisen, was the cutting of the pictures to 53½ minutes. The Court of Appeals limited decision to that situation. How much farther Republic could go was a question the resolution of which would necessarily depend on the specific facts of some actual dispute at a time when Republic was threatening to do more than it has done to date. In the present context, any such question was and is purely hypothetical and abstract, and, therefore, as the cases above-cited amply demonstrate, not an appropriate subject for either injunctive or declaratory relief.

Fourth: Even if we assume, although we do not concede, that the Court of Appeals erred in its analysis of the pleadings and evidence in this matter, it does not follow that there was any departure from the usual and accepted course of proceedings. The Court did not create any new or novel mode of procedure or disregard established rules of appellate review. Upon the indicated assumption, it merely arrived at an erroneous decision after applying to the case the conventional modes and methods of appellate adjudication.

It is thus apparent, as we said in the beginning, that the petition is merely a thinly disguised attempt to procure a further hearing of petitioner's assignment of errors. But, as we understand the rules and practice of this Court, that is not a proper or persuasive reason for intervention by way of certiorari.

II.

The Courts Below Recognized and Exercised Their Jurisdiction Under the Lanham Act and Properly Disposed of That Issue by Findings Which Negated Any Violation, Even Assuming Petitioner's Construction of the Act to Be Correct. It Thus Became Unnecessary to Decide Whether That Was in Fact the Correct Interpretation of the Statute.

Petitioner seeks to inject into this cause the question whether the Lanham Act establishes a Federal code of unfair competition, and if it does, whether it incorporates as criteria of unfair competition the general language of certain treaties. [Pet. 6, 15, 19-21.] That question was not and need not have been reached by either of the lower courts.

First: For present purposes we may assume, without conceding, that the Lanham Act does exactly what petitioner contends it does. The fact still remains that the District Court found, and the Court of Appeals affirmed, that Republic's proposed conduct "would not be or constitute unjust or unfair competition"; that it "would not be contrary to commercial good faith or the normal and honorable development of the motion picture and television industries"; that it "would not cause confusion in the public mind or injury to plaintiff's name or reputation"; and that it "would not be a false description of goods with respect to their nature, origin or quality . . ." [R. 275.] Assuming, as we have said, that the Lanham Act does lay down the definition of unfair competition which petitioner invokes, these findings, framed in the exact language of that supposed definition, explicitly negate its existence in the instant cause.

The findings are not challenged here. They are, in any event, supported by the fact that Republic has the right to do what is complained of by reason of contracts in which the petitioner agreed to exactly that to which he now objects [R. 265-270, 278]; by the statutory right to exhibit the pictures in any manner and by any method conferred by the Copyright Act [R. 264-265, 277. 17 U. S. Code, sec. 1(a)(d)]; and by the general right to full ownership of the results and products of an employee's services possessed by any employer. [R. 277-278. *Grant v. Kellogg Co.*, S. D. N. Y., 58 F. Supp. 48, 51, *affirmed*, 2 Cir., 154 F. 2d 59; *Houghton v. United States*, 4 Cir., 23 F. 2d 386, 389; *Bleistein v. Donaldson Lith. Co.*, 188 U. S. 239, 248; *Sawyer v. Crowell Pub. Co.*, S. D. N. Y., 46 F. Supp. 471, 473, *affirmed*, 2 Cir., 142 F. 2d 497, *cert. den.* 323 U. S. 735.]

In this view of the matter, it obviously became unnecessary to decide whether petitioner's contentions as to the scope of the Lanham Act and associated treaties were correct. Even assuming that he was entirely right in that regard, the *facts* did not bring him within the statute's protective reach. For exactly the same reason there is no necessity for deciding the question here.

Second: In view of this disposition of the matter, petitioner's complaint that the District Court did not in so many words find that it had jurisdiction under the Lanham Act [Pet. 6, 15, 19] becomes academic. The Court did find that its jurisdiction had been invoked thereunder. [R. 260-261.] And the fact is, as the findings to which we have referred show, it *exercised* that jurisdiction and decided the question, as it did the others, not by a dismissal for want of jurisdiction, but on the merits. [R. 282.]

Of course, the circumstance that it concluded that the statute had not been violated is no negation of the fact that it did decide, to the full extent called for by this record, the issues arising out of that legislation. [*Cf., Bell v. Hood,* 327 U. S. 678, 681-682; *Pagliero v. Wallace China Co.,* 9 Cir., 198 F. 2d 339, 341.]

III.

There Are No Questions of Any Public Importance Involved in the Cause.

The petition discloses nothing of public importance involved in this litigation. It is, in essence, an ordinary controversy between private persons over the meaning and effect of certain contracts between them. Resolution of that controversy has brought into operation no important or any legal principles; nor is there any claim of conflict, either with state law or with any other circuit. Indeed, except for one incidental citation not directed to any question involved [Pet. 20] there is not a single decision cited or discussed in the petition. There is not asserted the pendency of any other litigation involving any of the questions raised here; and notwithstanding that hundreds, if not thousands, of motion pictures, starring actors at least as prominent as petitioner, have been exhibited on television before and since this action and its companion case (No. 314) were commenced, there is no such other litigation so far as we are aware. In short, review of this cause by this Court would serve no useful purpose and would settle no question of any public importance. It would only afford to the party defeated in the Court of Appeals another hearing of his claim of error.

Conclusion.

For the reasons given above the petition for a writ of certiorari should be denied.

Respectfully submitted,

JOSEPH P. LOEB,
Attorney for Respondents.

HARRY L. GERSHON,
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Of Counsel.

APPENDIX.

Extended Statement of the Case.

A. THE PLEADINGS, FINDINGS AND JUDGMENT.

1. The complaint filed by petitioner is framed in three counts. In the first count the following is alleged:

a. Petitioner is a famous actor, whose principal business for many years has been the licensing of manufacturers, of products other than motion pictures, to use his name, voice and likeness for the purpose of advertising those products. [R. 4-5.]

b. From 1936 to 1947 petitioner rendered services to Republic as the star male performer in a number of motion pictures, made solely for exhibition to the public upon payment of an admission fee and not for the purpose of commercial advertising or exhibition over home television receivers. [R. 5-6.]

c. Petitioner has always exercised, and Republic has acquiesced in the exercise by him of, exclusive control over the use of his name, voice and likeness in commercial advertising. [R. 6-7.]

d. Republic has offered and is continuing to offer certain of the pictures, in which petitioner appeared, for televising over home television receivers, which offer contemplated the use of his name, voice and likeness for the express and only purpose of selling the products of the sponsor of the program (which includes the station or network if televised on a sustaining basis). Such use of name, voice and likeness will mislead the public into believing that petitioner approves or recommends the sponsor's products. [R. 7-8.]

e. The motion pictures were not produced, and in their original form are not suitable, for telecasting over home television. In order to render them suitable Republic intends to shorten them "to a length of only approximately 53 minutes and to be interrupted at several intervals during the showing of said motion picture so as to permit the insertion in a one-hour television program of approximately 7 minutes of advertising material for the purpose of advertising the product or products of the sponsor or sponsors of such television program." [R. 9.]

f. Republic's offers were made in disregard of petitioner's rights and will, in various ways, interfere with and injure petitioner's professional career and his commercial advertising business. [R. 10-11.]

g. Republic's conduct constitutes unfair competition. [R. 11.]

h. By its acquiescence in petitioner's course of conduct Republic has waived its rights to control the use of petitioner's name, voice and likeness for advertising purposes and is estopped to claim any such right. [R. 11-13.]

i. Republic is threatening to consummate a sale or licensing of the motion pictures for exhibition over home television receivers and for commercial advertising purposes. [R. 13-14.]

2. In the second count, the following is alleged:

a. Republic and petitioner between 1934 and 1947 entered into various employment contracts. These contracts are identified by dates, but their terms are not pleaded either *in haec verba* or in legal effect. [R. 14-16.]

b. Petitioner rendered services in sixty-four pictures produced under said contracts. [R. 16.]

c. An actual controversy between the parties with respect to those contracts exists in various particulars. In this connection Republic asserts that the contracts are valid, binding and effective; that all grants of rights thereunder are in full force and effect; and that it has the right "to sell, lease, license or otherwise distribute said motion pictures or any of them or any parts thereof for exhibition over home television receivers or for the purpose of commercial advertising and in connection therewith to cut, alter or rearrange said motion pictures and interpolate therein commercial advertising all without the consent of plaintiff." [R. 16-17.]

d. On the other hand, petitioner asserts that the contracts are void and illegal; that even if valid Republic has "no such asserted television rights" under them; that they should be so construed; and that notwithstanding this lack of right on its part Republic is offering the motion pictures for television exhibition, with irreparable damage to petitioner as a consequence. [R. 17-22.]

3. The third count consists of a re-allegation, by reference, of the allegations of the first count and the additional averment that the alleged conduct, carried on "without the consent of plaintiff is contrary to commercial good faith and the normal and honorable development of the motion picture and television industries"; and is a false description of goods, causes confusion in the public mind and injury to petitioner's name and reputation. [R. 22-23.]

4. The prayer was for:

a. A temporary restraning order, a preliminary and a permanent injunction against using, licensing, etc., petitioner's name, voice and likeness for advertising purposes or any motion picture in which his name, voice or likeness appears. [R. 23-24.]

b. An accounting of any sums received by Republic from such use. [R. 24.]

c. A declaration that the contracts are void and no television rights were granted thereby. [R. 24.]

d. If no such declaration is made, for a declaration "that no rights to exhibit the motion pictures starring plaintiff . . . over home television receivers and no right to use the name, voice and likeness of plaintiff for such purposes were granted by any of said agreements . . ." [R. 24-25.]

e. Costs and general relief. [R. 25.]

5. Republic's answer admitted the execution of the various contracts (copies of which were annexed); the production of 56 motion pictures thereunder and its intention to license them for television exhibition. It also admitted the existence of a controversy over these contracts; and that certain of the pictures were being shortened so as to be capable of being exhibited in 53½ minutes. Generally speaking, all other material allegations of the complaint were placed in issue by direct denials or averments of insufficient knowledge or information. [R. 36-46.]

6. Aside from these admissions and denials Republic affirmatively alleged the following:

a. All of the motion pictures were duly copyrighted and Republic at all times has been and is the owner of the copyrights, including the right to exhibit, reproduce and transmit the pictures, and to license others to exhibit, reproduce and transmit them, by any method now or hereafter devised. [R. 39.]

b. In addition to the controversy alleged in the complaint, Republic contends and petitioner denies that Republic as owner of the copyrights in the pictures has the right to exhibit or permit others to exhibit them in any manner or by any method whatsoever; that as petitioner's employer Republic became the sole and exclusive owner of the results and products of petitioner's services and of the right to use and license others to use such results and products; and that the contracts between the parties specifically recognize Republic's right to exhibit and to license others to exhibit the pictures in any manner and by any method now or hereafter devised. [R. 43-44.]

7. The District Court found, among other findings not necessary to be noticed in the present posture of the case, as follows:

a. The parties, by the agreements between them, intended and agreed that Republic should own perpetually and exclusively, without restriction or limitation, all right, title and interest in the motion pictures, including the right to distribute, transmit and exhibit

and to license others to distribute, transmit and exhibit them by any means or medium of distribution, transmission or exhibition of motion pictures then or now known or hereafter developed and for any purpose for which motion pictures are now or may hereafter be distributed, transmitted or exhibited. [R. 266-267.]

b. Specifically, the parties intended and agreed that Republic had and has the perpetual, exclusive and unlimited right to transmit and exhibit the pictures by any means of television transmission, now known or hereafter developed, on television programs whether commercially sponsored or sustaining and whether or not such programs carry advertising. [R. 266.]

c. Republic had the right to cut and edit or permit the cutting and editing of the pictures so as to allow, in connection with such television programs, the insertion of advertising at the start or close of and during their exhibition. [R. 266-267.]

d. The words "acts, poses, plays and appearances" have a fixed and customary meaning in the motion picture industry and as used in the contracts were understood and intended to have that meaning. The words mean and refer to the photographing and recording by motion picture camera and sound recording devices of the physical and vocal performances of an actor and the recordation thereof in and as part of a motion picture. [R. 267.]

e. The words "name, voice and likeness" as used in the contracts are generally understood in the motion picture industry and were understood and in-

tended by the parties to mean and refer only to the actor's name, voice and likeness apart from and independent of the appearance thereof in or as part of a motion picture. [R. 268.]

f. The parties, by their contracts, intended and agreed that Republic owned and should continue to own, perpetually and exclusively and without any restriction or limitation, all rights of every kind and character in and to petitioner's acts, poses, plays and appearances, including the right to distribute and exhibit them by any means or medium of distribution, exhibition or transmission. [R. 268-269.]

g. The right granted to Republic to use petitioner's name, voice and likeness was intended and agreed to be in addition to and independent of the aforesaid rights of distribution and exhibition and not as any qualification or limitation of the latter rights. [R. 269-270.]

h. Republic has not waived its rights nor is it estopped to assert them. [R. 270.]

i. Republic has offered to license the pictures for television exhibition. This offer permits advertising in conjunction with such exhibition, upon the condition, among others, (a) that the licensee should not make or permit to be made any statement directly, indirectly, expressly, or impliedly constituting an endorsement of any product by Republic or by any actor appearing in the licensed picture, or indicating any connection or association between Republic or any such actor and the television station or sponsor, and, (b) that any advertising or publicity referring to such actor should be limited to indicating that he

appears in or is rendering service in connection with the particular picture or pictures licensed. Said offer was not made maliciously, wilfully or in disregard of petitioner's rights, nor was it made for any purpose other than legitimate exploitation of Republic's rights in the pictures. [R. 270-272, 220.]

j. Since before 1934 it has been the established practice in this country to accompany the exhibition of motion pictures in theatres with advertising of other products. Republic also has licensed from time to time the non-theatrical exhibition of its pictures, free of admission charge to the viewing audience, in schools, auditoriums, ships, churches, department stores, hospitals, and the like. Theatrical and non-theatrical exhibition of motion pictures of this kind is not different in substance from the proposed exhibition of them on television in accordance with Republic's offer. [R. 272-273.]

k. Television exhibition of the pictures in connection with advertising would not cause the viewing audience to believe that petitioner endorsed or approved the advertised product or associate him with such product, would not constitute a use of his name, voice or likeness for advertising purposes and would not violate any of petitioner's advertising rights under the contracts. [R. 274.]

l. Exercise of Republic's rights would not constitute unjust or unfair competition or otherwise infringe petitioner's rights; would not be contrary to commercial good faith or the normal and honorable development of the motion picture or television industries; would not cause confusion in the public mind

or injury to petitioner's name or reputation; would not be a false description of goods with respect to their nature, origin or quality; and would not violate the Lanham Act (15 U. S. Code, secs. 1125, 1126). [R. 275.]

m. The contracts in suit are valid, binding and effective and all grants of rights thereunder are in full force and effect. [R. 275.]

8. Upon these findings a judgment was entered which declared the rights of the parties conformably thereto and dismissed the complaint on the merits. [R. 279-282.] Generally, it was declared that Republic had all right, title and interest in and to the motion pictures (including petitioner's acts, poses, plays and appearances therein) and the unqualified right to distribute and exhibit them by any means or medium and for any purpose for which motion pictures now or may hereafter be distributed and exhibited, including television exhibition with or without advertising; and that it had the right to cut, edit and otherwise revise the pictures in any manner and to any length, and the right to cut and edit them so as to allow insertion, in connection with television exhibition, of commercial advertisements.

9. The Court of Appeals, noting that the only issue made below with respect to cutting and editing did not go to the exercise of that right generally but only to its exercise to permit insertion of advertising, ordered modification so as to limit decision to Republic's right to shorten the pictures to 53½ minutes to permit of the interpolation of advertising. As so modified the judgment was affirmed. [R. 721-725; Pet. App. 1-5.]

B. The Facts.

1. The group of corporations collectively referred to herein as "Republic" are in the business of producing motion pictures and distributing them for exhibition to the public throughout the world by all known means of motion picture exhibition. [R. 262-266, 272-273.] Petitioner is a motion picture actor, specializing in so-called "western" or "cowboy" roles. [R. 272.]

2. From 1935 to 1947 petitioner was employed by Republic, under a series of employment contracts, to render his services as an actor in motion pictures to be produced and distributed by the latter. [R. 213-215, 261-264.] Some fifty-seven such pictures, designed for general distribution and exhibition to the public were produced. The relationship between Republic and petitioner was strictly that of employer and employee. [R. 213-215, 261-264, 277-278, 46, 74, 99-100, 134-135, 162-163.]

3. Contrary to petitioner's repeated assertion that he portrayed "himself, and not a fictional character" in these pictures [Pet. 3, 10] the fact is—and petitioner himself testified to it—that although the character which he portrayed was called "Gene" or "Gene Autry" it was in each picture a fictional and wholly different one. Thus, in one picture this fictional character might be a deputy sheriff in Nevada, in another a United States Marshal in Texas, in still another a cow-hand in Wyoming, and so on. Accordingly, each picture was independent of any other. [R. 416-417.]

4. (a) Each of the employment contracts here involved deals separately and expressly with two distinct groups of rights. The first group consists of the rights

to the results of petitioner's *acting services* as reflected *in the motion pictures* in which he appeared. These rights, referred to in the contracts as "acts, poses, plays and appearances," are reserved and granted perpetually and exclusively to Republic. [R. 51-53, 79-80, 96, 108-109, 143-144, 170-171.] And the motion pictures in which those results were to be recorded and reproduced are defined as including "motion pictures produced, exhibited with and/or accompanied by . . . television and all other improvements and devices which are now or which may hereafter be used in connection with the production, exhibition and/or transmission of any present or future kind of motion picture productions. . . ."[1] [R. 63-64, 96, 126-127, 160-161, 163.]

(b) The second group of rights dealt with in the contract relates to the use of petitioner's name, voice and likeness *outside of and apart from* these motion pictures, *i. e.*, to the use of those physical attributes in a context other than the portrayal of a dramatic or acting role. Here the contractual references are always to "name, voice and likeness." In this latter respect, Republic was given, in each of the contracts and *in addition* to the right to petitioner's acts, poses, plays and appearances, the *perpetual* right to use petitioner's name, voice and likeness for the purpose of advertising the pictures in which he appeared. It was also given, with varying limitations of time and scope, the right to use and permit others to use

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[1]The quoted language is from the 1938 contract [R. 126-127], under which twenty-eight of the fifty-seven pictures were produced. Identical or substantially similar language is found in the other contracts. [R. 63-64, 96, 160-161, 163.]

his name, voice and likeness to advertise other products.[2] [R. 53, 61-62, 80, 108-109, 144, 171, 517-523, 542-543.]

5. Each of the contracts, in varying language, recognized Republic's right to assemble and reproduce petitioner's acts, poses, plays and appearances in such form and order and at such length as the former desired. [R. 63, 127, 163.] Two of the contracts, under which twenty-eight of the pictures were produced, also provided that petitioner could be required to render his services only in "so-called 'feature' photoplays." [R. 127, 161.] It has never been contended that any of these twenty-eight was not a "feature photoplay." No limitation to features is found in the remaining contracts under which twenty-nine photoplays were made; although in one of them there was a prohibition of "serials." [R. 96.] Except for one made by Republic's predecessor under a contract containing no serial ban, no serials were, in fact, ever made. [R. 416-417.]

6. On June 8, 1951 Republic, in writing, offered to license various of its motion pictures, including certain

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[2]At the root of this entire controversy, and decisive of it, is this distinction between the two groups of rights with which the contracts deal. The reproduction and subsequent exhibition of an actor's "acts, poses, plays and appearances," *i.e.*, the results of his services, as they appear *in* the completed motion picture (which, of course, includes in a lose or broad sense, the photographic or electronic recordation of his name, voice and physical likeness in the *portrayal* of a dramatic role) is one thing; the use of his actual name, voice and likeness, *outside* of the motion picture and for a purpose which need not, and frequently will not, have any connection whatever with that picture and which is not the portrayal of an acting role, is quite a different thing. Once that distinction is appreciated, as it was by both the District Court and the Court of Appeals, it becomes quite clear that the admittedly broad grant or confirmation of the first group of rights is not and cannot be qualfied by the *additional*, even though limited, grant of the second. Petitioner himself testified that he understood the contractual language to connote this precise distinction. [R. 681-688.]

of those in which petitioner had appeared, for television exhibition. That offer was based upon a proposed licensing agreement containing the conditions, prohibiting use of the actor's name in advertisements, heretofore referred to. [R. 271-272, 220. See, also, sec. A, par. 7(i) of this statement, *supra.*] There was no evidence of any intention, proposal or threat by Republic to license its pictures for television exhibition in any manner or by any method other than those by which motion pictures were customarily exhibited on television; or to license them upon any conditions relating to advertising and publicity except those just noticed.

7. In order to fit the motion pictures proposed to be licensed into television time requirements, Republic had shortened them to a running time of 53½ minutes from their original length of about sixty-five minutes. This was done by eliminating padding or surplusage, shortening long "chase" sequences and, if necessary, by taking out an occasional extraneous scene. [R. 577-579.] There was no evidence that this shortening process made any substantial or discernible difference in the character or quality of the pictures or that they thereby became something other than a "so-called 'feature' photoplay." Nor was there any evidence of any intention, purpose or threat by Republic to do any more than cut the pictures to a uniform length of 53½ minutes while at the same time preserving their essential and original form, character and quality.[3]

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[3]Contrary to the general impression sought to be conveyed by the petition, the broad issue of Republic's right to cut or edit the pictures was *not* tendered by the complaint. What was tendered in the declaratory relief count, as has been seen [section A, par. 2(c) of this statement, *supra*], was the narrow issue whether, *in connec-*

8. Motion pictures have been and are customarily exhibited on television in three ways: (a) as part of a "sustaining program," which is presented by the television station and is announced as being so presented; (b) a "spot" program, which is similar to the sustaining except that at the beginning and end of the picture, and usually at one or more intervals during its showing, "spot" advertisements are shown; and (c) the "sponsored" program in which some concern other than the television station is identified as presenting the program and in the course of which its advertitsing appears.[4]

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tion with its claimed right to televise the pictures, Republic had the right "to cut, alter or rearrange said motion pictures and interpolate therein commercial advertising . . ." [R. 16-17.] In the injunction count the issue was even more precise, it being merely Republic's alleged intention to shorten the pictures to "approximately 53 minutes and to be interrupted at several intervals . . . so as to permit the insertion in a one-hour television program of approximately 7 minutes of advertising . . ." [R. 9.] Obviously, what was in the pleader's mind was not any question of the right to cut as such, but the right to cut for the purpose of enabling the picture to be shown on television in conjunction with advertising. Cutting was referred to as merely a mechanical phase of the *process* of television exhibition enabling advertising to be shown; the disputed *right* which was put in issue, however, was the right to televise on programs in which advertising appeared.

[4]These facts were judicially noticed in the District Court, all parties agreeing that the method by which an ordinary business is conducted was a judicially noticeable fact in California. [R. 680, 382. See, *e.g., Ogilvie v. Aetna L. Ins. Co.,* 189 Cal. 406, 414-415, 209 Pac. 26, 29-30; *Abbey Land etc. Co. v. San Mateo,* 167 Cal. 434, 439, 139 Pac. 1068, 1070; *Sawyer v. So. Cal. Gas Co.,* 206 Cal. 366, 375, 274 Pac. 544, 547-548.]

While petitioner now states that "No question was raised as to Republic's right to televise the motion pictures" [Pet. 11] the fact is that he classes all three exhibition methods as a use of name, voice and likeness for advertising purposes. [R. 7, 23, 305-307, 323.] The effect of his contention, therefore, as a practical matter, is to prevent Republic from exhibiting its pictures in any of the only ways in which motion pictures are presently exhibited on television. The District Court fully appreciated that this was the end result of the petitioner's argument. [R. 229, 230; Pet. App., 12.]

9. Motion pictures have long been presented in theatres in conjunction with advertising of other products. The number of theatres which do so has steadily grown, so that now nearly all of them follow this practice. These advertising films, as shown in theatres, run from 40 seconds to a minute and a half each. They advertise the same type of products in much the same way as they are advertised on television. In fact, many advertisers use the same filmed "commercial" in the theatre as they use on television. [R. 650-663, 219, 360-361, 473-475.] And the role of the motion picture in relation to advertising is exactly the same in the theatre as it is on television. It is the means by which the audience, which is to be subjected to the advertiser's message, is assembled. From the standpoint of the audience, whether theatre or television, the picture is entertainment; from the point of view of the advertiser it is the audience-attracter.[5] [R. 475-477.]

10. Motion pictures, including some in which petitioner appears, are not infrequently presented, without admission charge to the viewing audience, under the auspices or sponsorship of various non-theatrical or commercial organizations. [R. 678-679, 273; Ex. L.]

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[5]Republic's right to exhibit its pictures in theatres even when accompanied by advertising, as they are in virtually all theatres, is not disputed. Yet, the contracts, in dealing with exhibition rights, make no distinction whatever between any form or method of exhibition. [Section B, par. 4(a) of this statement, *supra*.] Why such a distinction should be grafted onto those contracts in respect of television, where the relation between the picture and advertising is exactly the same as it is in the theatre, is a question which petitioner has never been able to answer.